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In the

Supreme Court of the United States

OCTOBER TERM, 1977

ALFRED H. FAULKNER,

Petitioner,

vs.

BALDWIN PIANO & ORGAN CO.,
CHICAGO MUSICAL INSTRUMENT CO. et al,
THE WURLITZER COMPANY et al,
HAMMOND CORP. et al,
L & G ENTERPRISES, INC.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Petition

Petitioner, Alfred H. Faulkner, respectfully prays that a Writ of Certiorari issue to review the Opinion and judgment entered on August 15, 1977, as later modified by Order of October 11, 1977, by the United States Court of Appeals for the Seventh Circuit in its causes numbered 76-1588 through 76-1596.

Opinions Below

The original opinion of the Seventh Circuit Court of Appeals, issued August 15, 1977, is reported at 195 U.S.P.Q. 410-417, and is reprinted in the Appendix to this Petition at (App. pp. 1a-16a).* An Order of the Seventh Circuit Court of Appeals dated October 11, 1977, modifying the original Opinion is reprinted in the Appendix (App. pp. 18a-19a). The Opinion of the Court of Appeals, as modified, is reported at 561 F.2d 677. The Opinion of the District Court for the Northern District of Illinois is reported at 189 U.S.P.Q. 695-732.

Jurisdiction

The original Opinion of the Court of Appeals was entered August 15, 1977 (App. p. 1a). A timely petition for rehearing and for rehearing *en banc* resulted in an Order of October 11, 1977 modifying the Opinion, and denying the petition. (App. pp. 18a-19a). This Petition for Writ of Certiorari was filed within 90 days of the latter date. The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

QUESTIONS PRESENTED

First Question

Was Plaintiff denied due process, and improperly denied a jury trial of legal issues relevant to patent validity and infringement, and does the Court of Appeals' decision, by affirming summary judgment of patent invalidity, based on legal issues decided by a Court without a jury, constitute a direct conflict with the decisions by this Court in *Beacon Theatres* v. *Westover* 359 U.S. 500 (1960) and *Dairy Queen* v. *Wood* 369 U.S. 469 (1962)?

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* (App. p. —a) refers to a numbered page of the Appendix included herein following this Opinion and Brief.

Second Question

Where the Statute, 35 U.S.C. §282 details the presumptions of validity that accompany issue of a patent, and the bases founded in statute for holding a patent invalid, and where this Court in *Leeds & Catlin Co.* v. *Victor Talking Machine Co., et al* 213 U.S. 301, 319 (1909) ruled that each claim of a patent is an "independent invention", so that where a patent includes multiple claims ". . . the patent does not stand or fall as a unity . . .", then is the Seventh Circuit Court of Appeals' decision in direct conflict with the Statute and with this Court's ruling in *Leeds & Catlin* when it holds Claims 12 and 13 invalid without stating any statutory or decisional basis whatsoever for its holding;

and is the Court of Appeals' decision further in direct conflict with this Court's ruling in *McCarty* v. *Lehigh Valley RR Co.* 160 U.S. 110, 116, and in direct conflict with other Courts of Appeal, when it attempts to read limitations of Claim 1 into Claims 12 and 13?

Third Question

Where under Rule 56, F.R.C.P. a party moving for summary judgment has the burden of showing the absence of a genuine issue as to any material fact, and for these purposes the materials that it lodged in support of the motion must be viewed in the light most favorable to the opposing party, and where movant failed to foreclose all possibilities favorable to the party opposing the motion appearing from the movant's own documents, then isn't the Court of Appeals' decision below in direct conflict with this Court's decision in *Adickes* v. *Kress & Co.* 398 U.S. 144, 153-161 (1970), when the Court of Appeals fails to draw inferences from the materials favorable to the opposing party and rules that the party op-

posing the motion was required, on the basis of Rule 56(e), to provide affidavits or other evidentiary vehicles?

Fourth Question

Did the Court of Appeals misconstrue, misapply, or misconceive this Court's holding in *Muncie Gear* v. *Outboard, Marine & Mfg. Co.*, 315 U.S. 759 (1941) by invalidating Patent Claim 1 under 35 U.S.C. §102(b) by reason of a purported "public use" subsequent to the filing date of the patent application but prior to an amendment of patent Claim 1, without an amendment, at any time, of the description of the invention set out in the application as originally filed, and is the Court of Appeals' said ruling in direct conflict with rulings on the same issue by the Seventh and Tenth Circuit Court of Appeals, and in direct conflict on principle with a ruling by the Second Circuit Court of Appeals, thus requiring this Court to resolve the conflict?

Constitutional Provision, Statutes And Rules Involved

This case involves the Seventh Amendment to the Constitution (App. p. 19a); Rules 38, 39 and 42 F.R.Civ.Proc. (App. pp. 19a-21a); Rules 56(c), and 56(e), F.R.Civ. Proc. (App. p. 22a-23a); Section 102(b) of the Patent Act of 1952, 35 U.S.C. §102(b) (1952) (App. p. 24a); Section 121 of the Patent Act of 1952, 35 U.S.C. §121 (1952) (App. p. 25a); Section 282 of the Patent Act of 1952 as amended, 35 U.S.C. §282 (1965) (App. pp. 25a-26a); 37 C.F.R. §1.141 (1949); (35 U.S.C.A. App. I at 690) (App. p. 26a).

Statement of the Case

Petitioner, Alfred H. Faulkner, is the patentee and owner of U.S. Patent 2,811,069 entitled "Electrical Musical

Instrument", filed on March 3, 1951 and issued October 29, 1957.

Early in 1973, Petitioner filed separate suits against the five (5) Defendants named as Respondents herein. Each suit as filed: charged that the patent had been infringed during a period not more than six years prior to the filing of the Complaint, and would be infringed during the remainder of the term of the patent; sought recovery only in law, of an award of damages under 35 U.S.C. §284, adequate to compensate for the said infringement; and demanded a Jury Trial.

The suits were consolidated. In 4 of the 5 suits, the Answers pleaded, *inter alia,* affirmative equitable defenses of laches and/or estoppel.

Plaintiff suggested, on March 6, 1973 at a pretrial conference in chambers, that a separate and prior trial of the affirmative defenses of laches and estoppel be had under Rule 42 F.R.Civ.Proc. Plaintiff never waived his right to Jury Trial of the issues of patent validity and infringement in the manner specified in Rule 39 F.R.C.P. (App. p. 21a) Prior to a hearing of any evidence, Plaintiff moved on June 15, 1973 to strike the affirmative equitable defense of laches on the basis that the equitable defense of laches is no defense to an action at law. That motion was denied.

The district court invoked a preliminary hearing on June 26-27, 1973, limited to the affirmative equitable defenses of laches and/or estoppel. This preliminary hearing was terminated on June 27, 1973 with the district court stating that all issues should be tried "in one trial" (CA 124)* and that it would "not dispose of any laches

* (CA —) refers to the page of the Common Appendix filed by Plaintiff in the Court of Appeals.

defense preliminarily" (CA 135). The parties then proceeded with discovery on all issues.

At preliminary hearings on December 3, 1973 and January 4, 1974, Plaintiff repeatedly demanded its right to a Jury Trial of the entire case (CA 175, 178, 179, 184, 191, 192). At the hearing on December 3, 1973, the district court reiterated its view "that these things were so intertwined", and "that the trial on validity, infringement, laches and estoppel was going to take place all at one time" (CA 176). But the district court refused to grant Plaintiff's demand for a single Jury Trial of the entire case.

On January 4, 1974, the district court, after being reminded that it earlier had said it would "combine the trials" (CA 191), responded "You are perfectly right. I have changed my mind. Judges are permitted to do that." (CA 192). Reasons given earlier by the district court on January 7, 1974 for rejecting Plaintiff's demand for a Jury Trial of the entire case included:

> "I am not going to convene a jury trial to try—you know you asked for a jury trial. Fine, you are going to have a jury trial, if it is necessary to have a trial, on the issues of validity and infringement; but you are not going to have a jury trial on laches and estoppel, and that being the case, I think we will try laches and estoppel before the Court first, and get to the jury trial on the merits only if we get to it." (CA 184-185); and
>
> ". . . That is one of the crazy things about having a jury trial. You may get two different readings of the patent. That would be your problem. You asked for a jury trial. The defendants didn't. I didn't. I am going to read the patent my way for purposes of laches and estoppel. The jury can read it its way and we will never know how they read it because we just get a general verdict. . . . I am delighted that you asked for a jury trial. I wouldn't let you off the hook on that now if you tried." (CA 190-191)

The district court then proceeded, beginning June 6, 1974 and continuing intermittently until November 6, 1974, with evidentiary hearings in the absence of a Jury, ostensibly limited to the equitable defenses of laches and/or estoppel.

After the evidentiary hearings on defenses of laches and/or estoppel were concluded, Defendants moved, through a written motion dated January 13, 1975, for summary judgment: (1) that Claim 1 was invalid under 35 U.S.C. §102(b) and the "Muncie Gear" doctrine; (2) that Claim 1 was invalid under 35 U.S.C. §§101 and 112; (3) that Claim 1 was invalid under 35 U.S.C. §102 in view of prior art; (4) that Claims 12 and 13 were invalid under 35 U.S.C. §102 in view of prior art; (5) that Claim 12 was invalid under 35 U.S.C. §103 as being obvious over prior art; and (6) that Claim 13 was invalid under 35 U.S.C. §103 as being obvious over prior art. (CA 208-210)

At a hearing on January 14, 1975, the district court stated to Defendants' lead counsel: "Mr. Engel, no way that you can get summary judgment on the issue of infringement." and Defendants' counsel responded "I didn't ask for it on infringement." (CA 213)

The district court in its decision of April 16, 1976, *inter alia,* granted the motion for summary judgment only as to invalidity of Claim 1 under 35 U.S.C. §102(b) and the "Muncie Gear" doctrine, but denied all other bases for summary judgment of invalidity of Claims 1, 12 and 13 appearing in Defendants' written motion. The district court also ruled that defenses of laches and estoppel had been established, although concluding that such issues had

become moot, 189 U.S.P.Q. at p. 716 (Conclusion 3), and at p. 727 (Col. 2, par. 2) (CA 50, 61).

The district court itself raised, *sua sponte,* and ruled upon, bases for summary judgment that movant-defendants had not asserted in their written motion—first, the district court decided that Claims 1, 12 and 13 had not been infringed; second, the district court ruled that as a matter of law "an application and a patent may not incorporate two or more independent and distinct inventions" (189 U.S.P.Q. 726), citing case authorities and 37 C.F.R. §1.141, and asserting "If Claims 12 and 13 are not dependent upon Claim 1 . . . , they constitute independent and distinct inventions." The district court further stated in its "Conclusions of Law": "5. Summary judgment on the issue of validity of Claims 1, 12 and 13 of the patent in suit, is therefore, appropriate."

The Defendants had not moved for summary judgment on the basis of non-infringement. Nor had Defendants moved for summary judgment that Claims 12 and 13 were invalid either on the basis that Claims 12 and 13 were dependent on Claim 1, or that Claims 12 and 13 were for a different invention than Claim 1, and hence were in violation of Statutes and/or Rules (35 U.S.C. §121 and 37 C.F.R. §1.141). The district court's rulings on all three of these issues came without any notice to Plaintiff that such issues were even being considered by the court.

Plaintiff appealed to the Court of Appeals, contesting the district court's denial of Plaintiff's right to a Jury Trial, contesting all rulings on patent invalidity and non-infringement, contesting the right of the district court, on the basis of this Court's ruling in *McCarty* v. *Lehigh* 160 U.S. 110, 116 (1895) and subsequent legal authority, to read into a patent claim an element which is not present,

and also contesting the district court's rulings that the defenses of laches and estoppel had been established.

Arguments presented to the Court of Appeals in Plaintiff's Main Brief, Reply Brief, or in oral argument, attacked the power of a district court to itself become a moving party to initiate, rule upon, and dispose of a suggested ground for summary judgment under Rule 56 F.R.C.P., on the basis that such a procedure lacks "due process of law" and because when a court itself suggests a ground for disposition by summary judgment under Rule 56 F.R.C.P. during the court's decision making process, the party who would normally oppose the motion will not have been given any opportunity to be heard on the issues, or to file opposing affidavits as is provided for by the second sentence of Rule 56(c) F.R.C.P.

An argument was also presented to the Court of Appeals that Faulkner's Constitutional rights under the Seventh Amendment had been abrogated by the district court, and that Plaintiff had not been accorded any opportunity to put in his case. On the latter point, the district court had stated on January 14, 1975:

> "The Court: I really don't think we had a trial on the issue of validity. Nobody in his right mind would say that." (CA 220)

The Court of Appeals, in its Decision dated August 15, 1977 did not rule on the majority of the appealed issues raised by Plaintiff's Appeal. The Court of Appeals affirmed only the district court's ruling that Claim 1 was invalid under the "Muncie Gear" doctrine (App. p. 13a), and as to Claims 12 and 13, the Court of Appeals stated, *inter alia,* ". . . those claims, which are dependent on Claim 1, are invalid under *Muncie Gear* . . .". (App. p. 14a)

Plaintiff then filed a timely petition for rehearing, and for rehearing *en banc,* pointing out, *inter alia*: (a) conflict between the Court of Appeals' Decision and this Court's Decision in *Adickes* v. *Kress & Co.* 398 U.S. 144 on the correct interpretation of Rule 56(e) F.R.C.P.; (b) the Court of Appeals erred in holding that Claims 12 and 13 were dependent on Claim 1 and invalid under *Muncie Gear,* since Claims 12 and 13 were not dependent on Claim 1, and because Claims 12 and 13 were last amended on July 27, 1954, they could not have been invalid under any possible interpretation of *Muncie Gear*; (c) that *Muncie Gear,* since it requires amendment of a patent application's written description, is not applicable to the case at bar since there had been no amendment of the written description of the patent in suit; and (d) that the Court of Appeals' ruling, in connection with invalidity of Claims 12 and 13, leading to a conclusion that 35 U.S.C. §121 and 37 C.F.R. §1.141, together create a presumption, conflicting both with decisional authority of this Court in *Leeds & Catlin* v. *Victor Talking Machine Co.* 213 U.S. 301 (1909) and with the statutory presumption of validity in 35 U.S.C. §282.

The Court of Appeals in an "Order" dated October 11, 1977 (App. p. 18a) then changed its slip Opinion to eliminate both its ruling that Claims 12 and 13 were dependent upon Claim 1, and its reliance upon *Muncie Gear* to declare Claims 12 and 13 invalid. The portion of the "Order" of October 11, 1977 that operated to modify or correct the Court of Appeals' original Opinion of August 15, 1977 was suggested by Defendants in their Brief filed in opposition to the petition for rehearing.

The Court of Appeals' "Order" of October 11, 1977 denied the petition for rehearing.

REASONS FOR GRANTING THE WRIT

I. AS TO THE FIRST QUESTION

This Court's decision in *Beacon Theatres*[1] holds that where both legal and equitable issues are presented in a single case, "only under the most imperative circumstances which in view of the flexible procedures of the Federal Rules we cannot now anticipate, can the right to a jury trial of legal issues be lost through prior determination of equitable claims." (359 U.S. at 510, 511)

This Court's decision in *Dairy Queen*[2] holds that in a case where there cannot even be a contention of such "imperative circumstances", *Beacon Theatres* requires that any legal issue for which a trial by jury is timely and properly demanded be submitted to a jury. (369 U.S. at 473)

In the appeal below, Petitioner directed attention of the Court of Appeals to *Beacon Theatres* and *Dairy Queen* by squarely posing appeal issues that involved those decisions.[3]

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[1] *Beacon Theatres* v. *Westover,* 359 U.S. 500, 3 L.Ed. 2d 988 (1960).

[2] *Dairy Queen* v. *Wood,* 369 U.S. 469, 8 L.Ed. 2d 44 (1962).

[3] In the Court of Appeals, Petitioner presented at p. 5-6 of the Main Brief the following statement of issue:

> *ISSUE 2.* Did the District Court err, procedurally and substantively, by itself hearing and deciding contested fact matters related to affirmative equitable defenses of laches and estoppel pleaded by four of the Defendants, in a patent infringement action where only money damages were sought, and a jury demand had been made?
>
> *FIRST SUB-ISSUE*: *Procedurally,* did the District Court err in proceeding contrary to the ra-

The Opinion of the Court of Appeals below never mentions or discusses this Court's decisions in *Beacon Theatres* and *Dairy Queen*. The Court of Appeals dismissed Petitioner's appeal issues, that were based upon the district court's denial of a Jury Trial to Petitioner, by saying (App. p. 4a).

> ". . . Because summary judgment was proper on this record, there was no need for the district court to hold a jury trial as to the validity of plaintiff's patent. *Research Corp.* v. *NASCO Industries, Inc.* 501 F.2d 358 (7th Cir. 1974); *Townsend Co.* v. *M.S.L. Industries,* 359 F.2d 814 (7th Cir. 1966).

Neither of the foregoing case authorities cited by the Court of Appeals involved a demand for a jury trial. Therefore, the two case authorities cited do not provide support and law for the Opinion or Ruling asserted by the Court of Appeals.

The Court of Appeals' affirmance of summary judgment under *Muncie Gear,* based upon a purported "public use" in 1955, was founded upon oral testimony of Anderson (App. pp. 8a-11a). There was no corroboration of Anderson's testimony concerning what existed in 1955. To the contrary, there were contemporaneous written reports of 1956 and 1957 by Hammond Engineer Alan Young re-

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[3] (Continued)

> tionale of the Supreme Court's rulings in *Beacon Theatres* v. *Westover,* 359 U.S. 500 (1959), and *Dairy Queen* v. *Wood,* 369 U.S. 469 (1962), by conducting a non-jury hearing on affirmative equitable defenses pleaded by Defendants, when the facts relevant to the defenses of laches and estoppel necessarily were inextricably interwoven with fact issues that the Court recognized were proper for trial by the jury, as Plaintiff's Complaints had demanded!

porting on the models demonstrated at the 1955, 1956 and 1957 (CA 360-365) NAMM Shows. (App. p. 10a-13a) These reports establish Young's conclusions that the Lowrey SS Model organs of the 1955 and 1956 Shows were "AC keyed", and that the Lowrey organ at the 1957 Show had ". . . the keying is improved to D.C.-keying, which eliminates key click and makes possible slow decay percussion after keys are released." (App. p. 10a).

When one appreciates that the sole basis for invalidating Claim 1 has been founded on the premise by the district court that the 1955 Lowrey SS organ had D.C. keying, while Young's report was that "D.C.-keying" was introduced by Lowrey in 1957, the need for a Jury Trial to resolve the disputed issue is pointed up. The Court of Appeals itself recognized that the conflicting evidence resulted in an "inconsistency" (App. p. 10a). A jury would have been uniquely appropriate to decide this contested fact issue, not only based upon the weight of testimony, but also on the basis of credibility of live witnesses, since both Anderson and Young were available and both testified at the hearings before the district court.

The Court of Appeals' failure to observe the rulings and rationale of *Beacon Theatres* and *Dairy Queen* results in the Court of Appeals' decision being in direct conflict, as a matter of law, with this Court's decision in *Beacon Theatres* and *Dairy Queen.*

As to the denial of due process to Petitioner, it is evident from the recital of facts in the Statement of the Case, *supra,* that Petitioner demanded a jury trial repeatedly in that the district court acknowledged on January 4, 1974 that Petitioner was entitled to a jury trial on the issues of validity and infringement, and in effect promised Petitioner such a trial. But then, after a bench trial

that purportedly was limited to laches and estoppel, the district court proceeded to decide issues of validity and infringement without giving Petitioner the jury trial it had promised, or permitting Petitioner to be fully heard. The district court confirms that Petitioner could not have had an opportunity to be fully heard when, following the bench trial, it stated on January 14, 1975:

> "The Court: I really don't think we had a trial on validity. Nobody in his right mind would say that." (CA 220)

What is particularly appalling is that the district court decided the patent infringement issues, and certain of the patent validity issues, *sua sponte*. Respondents-Defendants expressly disclaimed seeking summary judgment on infringement (CA 213). Therefore, the action by the district court in deciding infringement by summary judgment *sua sponte* operated to deprive Petitioner not only of an opportunity to be heard but also operated to deprive Petitioner of the "right" to file affidavits as provided for by the second sentence of Rule 56(c)[4].

II. AS TO THE SECOND QUESTION

35 U.S.C. §282 (App. p. 25a) details both the statutory presumptions of patent validity and the bases for determining if a patent or any claim is invalid. The relevant presumptions are broad: "A patent shall be presumed valid."; and also specific: "Each claim of a patent . . . shall be presumed valid independently of the validity of other claims."

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[4] Under "Rule 56—Summary Judgment", after a motion for summary judgment has been filed, Rule 56(c) provides as a right: ". . . The adverse party prior to the day of hearing may serve opposing affidavits."

As to invalidity of a patent claim §282 states: "The burden of establishing invalidity of a patent or claim thereof shall rest on the party asserting it."; and the specific bases for "invalidity" are stated in sub-sections (2) and (3) of §282 and are required to be related to "any ground specified in Part II of this title as a condition for patentability". In other words, the bases for patent invalidity must be related to specific "Sections" of the Statute.

The statutory presumption that each claim of a patent shall be presumed valid "independently of the validity of other claims", is consonant with this Court's ruling in *Leeds & Catlin Co.* v. *Victor Talking Machine Co.* et al, 213 U.S. 301, 319, 53 L.Ed. 805, 813 (1909), where this Court said:

> "Claims are independent inventions. . . . One claim may be valid, all the rest invalid, invalid for the want of some essential patentable attribute. But what is good remains and is unaffected by its illegal associates. In such cases the patent does not stand or fall as a unity. . . ."

has remained in effect and has been cited, since enactment of the 1952 Patent Act, by Courts of Appeal.[5]

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[5] *Smith Industries International* v. *Hughes Tool Co.*, 396 F.2d 735, 736 (5th Cir. 1968) states:

> ". . . Of course, separate claims in the same patent are independent inventions."

Maloney-Crawford Tank Corp. v. *Sauder Tank Co., Inc.*, 465 F.2d 1356, 1365 (10th Cir. 1972) states:

> "Separate claims in the same patent are in effect separate inventions. . . . The fact that a particular claim within a patent is invalid, without more, cannot invalidate the entire patent. Each claim of a patent must be considered separately and each must stand or fall alone."

In the case below, decided on summary judgment, Respondents had the burden under §282 of establishing invalidity of the claims at issue. Under sub-sections (2) and (3) of §282, Respondents had the burden and duty of identifying the "Sections" of 35 U.S.C. which establish invalidity of each patent claim asserted to be invalid.

In Respondents' motion for summary judgment filed in the district court, the statutory bases asserted for invalidity of Claims 12 and 13 were 35 U.S.C. §§ 102 and 103. The district court rejected the assertions of invalidity of Claims 12 and 13 under either §102 or §103. The district court did not hold Claims 12 and 13 invalid under *Muncie Gear* or under §102(b).

The Court of Appeals, in its original Decision of August 15, 1977, did find Claims 12 and 13 invalid under *Muncie Gear,* whose statutory basis is §102(b). The operative sentence of the Court of Appeals' original decision of invalidity of Claims 12 and 13 reads:

> "As Judge Will held, since the 'keyer' referred to in Claims 12 and 13, is the keyer of Claim 1, those claims, which are dependent on Claim 1, are invalid under *Muncie Gear* if read to include any keyers using non-linear conducting devices."

In its Petition for Rehearing, Petitioner herein pointed out that Claims 12 and 13, reproduced in footnote "11" (App. p. 14a) of the Court of Appeals' decision, were clearly not written as dependent upon Claim 1, the latter being reproduced in footnote "7" (App. p. 9a) of the Court of Appeals' decision. Additionally, Petitioner pointed out that since Claims 12 and 13 had been last amended on July 27, 1954, a date prior to any allegedly critical date, those claims could not have been found invalid under *Muncie Gear* under any circumstances.

The Court of Appeals then requested Defendants, Respondent herein, to file their views on Plaintiff's Petition For Rehearing. Defendants filed a Brief suggesting, *inter alia,* revisions in the operative portion of the Court of Appeals' decision that held Claims 12 and 13 invalid. The Court of Appeals adopted Defendants' recommendations, so that the operative sentence of the Court of Appeals' modified decision now reads as follows:

> "As Judge Will held, since the 'keyer' referred to in Claims 12 and 13, is the keyer of Claim 1, those claims are invalid if read to include any and all keyers using non-linear conducting devices."

As is evident from the revised operative sentences of the Court of Appeals' opinion, there now exists no statutory basis whatsoever, relied upon by the Court of Appeals for invalidity of Claims 12 and 13. In its original opinion, *Muncie Gear* supplies §102(b) as a statutory ground for invalidity. In the revised Opinion no statutory basis for invalidity appears. In this respect, the Court of Appeals' decision is in direct conflict with subsections (2) and (3) of 35 U.S.C. §282.

Any arguendo invalidity of Claim 1 under §102(b) is inappropriate and insufficient to establish invalidity of Claims 12 and 13, not only by the express terms of §282, but also in view of this Court's ruling in *Leeds & Catlin.*

While the district court purported to question validity of Claims 12 and 13 under the provisions of 35 U.S.C. §121, and in reliance upon three decisions[6], the Court of

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[6] None of the three cases cited by the district court supports its reliance upon §121 as a basis for invalidity of Claims 12 and 13. The Court of Appeals never refers to the case authority cited by the district court.

Appeals in footnote "12" not only tacitly rejects the district court's basis for ruling in reliance on §121, but states that:

> "Thus, if it is manifest that a single issued patent claims two or more independent and distinct inventions, the patent would be valid, assuming it was free of other defects."

The petitioner's contentions in the district court and in the Court of Appeals were to the effect that the broader language used in Claims 12 and 13 encompasses different combinations than the narrower language used in Claim 1. While the language of those Claims speaks for itself, the Court of Appeals purports to read into Claims 12 and 13 the limitations of Claim 1, saying:

> ". . . the term 'electronic keyer' in Claims 12 and 13 does not have a different meaning than the described keyer in Claim 1." (App. p. 15a)

However, that holding by the Court of Appeals is in direct conflict with this Court's ruling in *McCarty* v. *Lehigh Valley RR Co.*, 160 U.S. 110, 116 (1895) which says:

> ". . . We know of no principle of law which would authorize us to read into a claim an element which is not present. . .".

The principle derived from *McCarty* is that a court may not read language into a claim when the language does not appear in the claim. The same principle was recently enunciated by the Second Circuit in *Maclaren* v. *B-I-W Group Inc.*, 535 F.2d 1367 (2 Cir. 1976). Also see *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 418 (1907).

III. AS TO THE THIRD QUESTION

This Court's decision in *Adickes*,[7] which in part relies upon *Diebold*,[8] holds that where a summary judgment movant fails to foreclose possibilities favorable to the opposing party that appear from the materials submitted by movant, the movant has failed to fulfill its initial burden under Rule 56(c), and that Rule 56(e), as amended in 1963, does not, under such circumstances, require the party opposing the motion "to come forward with an affidavit" asserting the affirmative of the possibilities.

Adickes further establishes that ". . . both the commentary and background of the 1963 amendment [of Rule 56(e)] conclusively show that it was not intended to modify the burden of the moving party under Rule 56(c) to show initially the absence of a genuine issue concerning any material fact" (398 U.S. at 195).

The Court of Appeals was advised of *Adickes* and *Diebold* in Petitioner's Main Brief on appeal. The Petition for Rehearing called the Court of Appeals' attention to the fact that its ruling on Rule 56(e) was in direct conflict with the reasoning and decision in *Adickes*, and again cited *Diebold*. The Court of Appeals' Opinion makes no reference to either *Adickes* or *Diebold*.

What makes *Adickes* so directly relevant herein is that the movant in *Adickes* argued, as the Court of Appeals in substance held below, that under Rule 56(e) as amended in 1963, ". . . it was incumbent on petitioner to come forward with an affidavit" properly asserting the affirmative of the possibility that had not been foreclosed by the

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[7] *Adickes* v. *Kress & Co.*, 398 U.S. 144, 153-161 (1970)

[8] *United States* v. *Diebold, Inc.*, 369 U.S. 654, 655 (1962)

movant under Rule 56(c) (398 U.S. at 159). But this Court expressly held "This argument does not withstand scrutiny. . ." (398 U.S. at 159).

There is nothing in the instant case which differs in principle from the set of circumstances that resulted in the reasoning and decision in *Adickes.* In *Adickes,* the non-foreclosed possibility was "the presence of the policeman in the store" (398 U.S. 159). In the case below, the non-foreclosed possibilities were that the 1955 Lowrey model had only AC keying therein and no D.C.-keying, and that the Lowrey model present at the 1955 show was only "experimental" and, therefore, incapable of "public use".

In the instant case, the Court of Appeals does note the "report by Hammond engineer Alan Young on the SS model demonstrated at the 1956 NAMM Show", does note that "Some AC keying circuits can give the impression of sustain", and does note that the chart appended to Young's report states that the Lowrey organ had "AC" keying (App. p. 10a). The Court of Appeals also quotes from the Young report on the 1957 NAMM Show:

> "'The *Lincolnwood,* costing $1,695.00 became available this year and is the experimental model shown at the two previous Shows. It contains the same generator system, but the keying is improved to D.C.-keying, which eliminates key click and makes possible slow decay percussion after keys are released.' (P. App. 364)" (App. p. 10a)

Based upon the foregoing, the Court of Appeals tacitly concedes the existence of possibilities favorable to the party opposing the motion, namely that the 1955 organ did not have DC-keying, and that what was at the 1955 and 1956 shows was merely "experimental", when the

Court refers to "This apparent inconsistency. . ." (App. p. 10a). However, the Court of Appeals then fails to follow this Court's mandate that "'[o]n summary judgment the inferences to be drawn from the underlying facts contained in [the moving party's] materials must be viewed in the light most favorable the party opposing the motion' *United States* v. *Diebold, Inc.* 369 U.S. 654. . .". Instead, the Court of Appeals then proceeds in direct conflict with the holdings of this Court in *Adickes* and *Diebold,* to attempt to resolve the "inconsistency" by itself drawing inferences favorable to the movant.

Finally, the Court of Appeals relying upon a 5th Circuit decision in 1967,[9] holds that "plaintiff was obliged to provide affidavits or other evidentiary vehicles to set forth specific facts showing a genuine issue of whether the SS model shown in 1955 was "D.C.-keyed". The Court of Appeals does not explain why the 1967 decision by the 5th Circuit is more relevant to, or controlling upon, the issue than the more recent decision of this Court in 1970 in *Adickes.* It can only be inferred that the Court of Appeals recognized that this Court's decision in *Adickes* required reversal by the Court of Appeals, and the Court of Appeals then deliberately chose to be in direct conflict with the ruling in *Adickes.*

IV. AS TO THE FOURTH QUESTION

In *Muncie Gear,* the original application for patent had been filed August 25, 1926. Public use and sale by, or on behalf of, the patent applicant began in Jan.-Feb. 1926. Competitors of the patent applicant also began selling accusable devices in 1926. An amendment of the original

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[9] *Southern Rambler Sales, Inc.* v. *American Motors Corp.,* 375 F.2d 932, 937 (5 Cir. 1967)

description of the patent application was filed on March 30, 1929 to provide support in the description for patent claims that were also presented on March 30, 1929.

This Court, in *Muncie Gear,* placing emphasis on the amendment of the description[10] in the patent application, reasoned that a new original application, if it had been filed on the amendment date of March 30, 1929, would have been invalid as a matter of law by reason of a statutory bar in 1929 based upon the public sale that dated back to 1926. Based upon the foregoing set of circumstances, this Court held those claims that were supported by the March 30, 1929 amendment were invalid, and this gave rise to what is known as the *Muncie Gear* doctrine.

The patent claims held invalid under the *Muncie Gear* doctrine made reference to a "smooth housing", a feature that was added by the March 30, 1929 amendment to the description. The importance of the amendment of the description which introduced the "smooth housing" feature is further emphasized by the fact that the final specification of the patent involved in *Muncie Gear* included about 35% of the total text that had been added by the amendment of March 30, 1929.[11]

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[10] *Muncie Gear* states, 315 U.S. at 763, ". . . the amendment [of March 30, 1929] also set forth an addition to the description which was incorporated in the description of the patent as issued. Here we find the expression 'relatively smooth and substantially stream-line surfaces.' Other than these, no indication of the nature of the surface or cross section of the housing was given at any time during the prosecution of the application."

[11] An analysis of the quantity of amendatory material in the patent of the *Muncie Gear* case is found in a textbook entitled "Patent Preparation And Prosecution", Vol. II, Sutton, Conlin & Schwab, edited by Irving Kayton, published by Patent Resources Institute, Inc., copyright 1976 (May), 1977 (June), Chapter 8, pages 8-19.

From the foregoing, it can be inferred that the thrust of the *Muncie Gear* doctrine is that a patent applicant, who has filed an original patent application, may not properly amend the description of his invention at a date when the bar of the statute (now 35 U.S.C. §102(b)) would have made invalid the filing of a new original patent application, and if the Patent Office does permit such an amendment of the disclosure, then the claims which derive support from the amendatory material to the description, will be found invalid in view of the statutory bar.

However, where an originally filed patent application's description has not been amended, other Circuit Courts of Appeal have uniformly refused to find invalid those patent claims that were amended, or entered by an amendment, subsequent to the critical date established by the bar of the relevant statute (35 U.S.C. §102(b))[12].

Thus, the Second Circuit Court of Appeals stated at an early date (1946) the principle followed by said Courts of Appeals in the following terms:

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[12] In the Tenth Circuit: *King-Seeley Thermos Co.* v. *Refrigerated Dispensers, Inc.* 354 F.2d 533, 539 (10 Cir. 1965). ". . . a patent claim is valid even if added to a patent application for the first time after another has manufactured and sold an infringing product if that claim is supported by the disclosure in the patent applica- filed before such use or sale by the infringer." Citing *Sears, Roebuck & Co.* v. *Jones,* 308 F.2d 705, 708 (10 Cir. 1962).

In the Seventh Circuit: *Binks Mfg. Co.* v. *Ransburg Electro-Coating Corp.* 281 F.2d 252, 257 (7 Cir. 1960). The *Muncie Gear* doctrine is inapplicable where " . . . the original application disclosed the basis for the amended claim and there is no evidence of public use more than one year before the invention was first presented to the Patent Office."

> " 'The doctrine [of *Muncie Gear*] is designed to protect the public against abuses, not to deprive inventors of what they plainly never meant to put into the public demesne. It is enough here to say that it certainly does not prevent amendments which go no further than to make express what would have been regarded as an equivalent of the original; . . .' *Engineering Development Lab.* v. *Radio Corp. of America,* 153 F.2d 523, 526 (2nd Cir. 1946)."

The question of scope of the patent claim, amended or introduced by amendment, has nothing to do with the *Muncie Gear* doctrine, as a patentee is entitled to broaden his claims during prosecution so long as the broadened claims are supported by the original disclosure.[13]

There do exist a number of cases that have applied the *Muncie Gear* doctrine either improperly or under unusual circumstances, but principally where the amendment made subsequent to public use involves an application that is not an original application. Thus, although the Seventh Circuit Court of Appeals in its Decision below cites *Chicopee Mfg. Corp.* v. *Kendall Co.,* 288 F.2d 719, 723-724 (4 Cir. 1961), the fact is that the patent application in *Chicopee* was not an original application but was an application for reissue, and further, the description of the invention in the reissue patent application had been changed by amendment to omit "cross" from the description of the weave, and to limit the fabric to diaper fabric instead of to fabric in general (288 F.2d at 722). Another case requiring notice and comment is *Kahn* v. *Dynamics Corp. of America,* 367 F.Supp. 63, 73, aff'd. 508 F.2d 939 (2 Cir. 1974), cert. den. 421 U.S. 930. In *Kahn* the court's reliance upon *Muncie Gear* turns out to be

[13] *American Anode, Inc.* v. *Lee-Tex Rubber Prods. Corp.,* 136 F.2d 581, 585 (7 Cir. 1943).

dicta since the claims were invalid for other statutory reasons. Further, no claims corresponding to the scope of Claims 15 and 16 at issue had been presented by amendment during the full prosecution of the original application for patent that had been filed July 3, 1953. Nor were said claims presented at the time of filing the "continuing" application on December 13, 1960. The said Claims 15 and 16 at issue had been first presented in a "continuing" application by an amendment.

From the foregoing, it can be seen that the *Muncie Gear* doctrine does not come into operation merely by the amendment of claims, or by the insertion of new claims by amendment, during the course of prosecution of an original patent application. The *Muncie Gear* doctrine comes into play in connection with an original patent application only when the description of the invention is amended subsequent to the critical date established by 35 U.S.C. §102(b), and when such description then provides a basis of support for claims that are then, or later, also amended or introduced by amendment.

The issue involved under this Fourth Question is of great importance to the patent bar at large. This Court must resolve the conflict between Circuit Courts of Appeals that has stemmed from misconstruction, misapplication or misconception of this Court's *Muncie Gear* Decision. It is submitted that the policy enunciated by Judge Learned Hand in *Engineering Development* as quoted hereinabove, should be the policy adopted by this Court in resolving the conflicting views concerning the *Muncie Gear* doctrine.

In this case, Petitioner's description of his invention in his patent was never amended. Therefore, any amendment to patent Claim 1 was proper, as long as it was supported

by the description in the patent application. The record herein reflects that the Patent Office never criticized the amendment presented by Petitioner in December 1956 as not supported by the patent application. Since the Patent Office accepted that amendment, *Muncie Gear* is wholly inapplicable to the patent involved in this case.

CONCLUSION

For the reasons stated, this Petition for Certiorari should be granted.

Respectfully submitted,

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APPENDIX

IN THE
UNITED STATES COURT OF APPEALS
For The Seventh Circuit

Nos. 76-1588 through 76-1596
ALFRED H. FAULKNER,
Plaintiff-Appellant,
v.
BALDWIN PIANO & ORGAN CO., *et al.*,
Defendants-A[illegible].

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.
Nos. 73C 136, 139, 140, 793, and 794.
HUBERT L. WILL, *Judge*.

HEARD APRIL 25, 1977—DECIDED AUGUST 15, 1977

Before CUMMINGS and PELL, *Circuit Judges*, and GORDON, *District Judge*.*

CUMMINGS, *Circuit Judge*. Plaintiff is a patentee and the owner of U.S. Patent No. 2,811,069 for an electrical musical instrument. The patent issued on October 29, 1957, from an application filed on March 3, 1951. It expired on October 29, 1974. Plaintiff prepared the patent

* District Judge Myron L. Gordon of the Eastern District of Wisconsin is sitting by designation.

application himself and prosecuted it on the merits *pro se*.[1]

In 1973, plaintiff filed five suits against defendants claiming that their electronic organs infringed Claims 1, 12 and 13 of his patent. In each complaint, plaintiff demanded a jury trial in accordance with Rule 38(b) of the Federal Rules of Civil Procedure and limited his claim under 35 U.S.C. § 284 for money damages only. In the complaints filed January 17, 1973, against Baldwin, Chicago Musical Instrument Co. and Wurlitzer, Faulkner asserted he first learned of these defendants' infringement in April 1972. In the complaints filed March 29, 1973, against Hammond and L & G Enterprises, Inc. plaintiff asserted he first learned of their infringement in 1973. All five complaints limited the claim for recovery under 35 U.S.C. § 286 to infringing acts occurring within the period of "six years prior to the filing of the Complaint" and to any infringing acts occurring subsequent to the filing of the complaint. The cases were consolidated for trial and appeal.

The defendants, except L & G Enterprises, Inc., first asserted the affirmative defenses of laches and estoppel, and the district court held preliminary hearings limited to those subjects on June 26-27, 1973. After June 27, 1973, discovery proceeded on all issues. Judge Will held

[1] Plaintiff is the sole or joint owner of 69 patents. A highly experienced electronics engineer, Faulkner had once seriously considered becoming a patent lawyer while attending DePaul Law School in Chicago, and for a time worked in the patent departments of two corporations and in a Chicago patent law firm.

The patent involved in this suit was plaintiff's only organ patent. After 1957, plaintiff was not directly associated with the organ industry, being employed in space and military research for the federal government. However, during the entire period from 1957 to 1970 he intermittently worked on his prototype organ and in 1970 began development of an electronic music synthesizer. 189 US PQ at 701.

a 35-day bench trial on the issues of laches and estoppel beginning on June 6, 1974, which continued intermittently until November 6, 1974. On January 14, 1975, the same defendants filed motions for summary judgment on the ground that the stipulation of uncontested facts and the evidence already before the court established that the Faulkner patent is invalid. On April 16, 1976, the district court entered 219 findings of fact and 16 conclusions of law, together with a comprehensive opinion holding that plaintiff's complaint must be dismissed with prejudice and with costs to defendants. These rulings are reported in 189 USPQ 695.

In its conclusions of law, the district court held that summary judgment was appropriate on certain validity issues as to Claims 1, 12 and 13 of the Faulkner patent "since the prior art, history of the prosecution of the application leading to the issuance of the patent and the patent itself are all documents capable of interpretation upon examination and all other facts relevant to validity are undisputed" (189 USPQ at 716). The court refused to rule on various grounds of invalidity tendered by defendants where material issues of fact existed (189 USPQ at 717-719; 726-727).

Claim 1 of the patent was held invalid under the "late claiming" doctrine of *Muncie Gear Works, Inc.* v. *Outboard Marine & Mfg. Co.*, 315 U.S. 759, and under 35 U.S.C. § 132[2] if read to encompass keying of square waves by all forms of non-linear conducting devices. However, Claim 1 was held valid when properly read with its scope limited to the keying of the square waves by the use of neon or glow tubes. Since none of defendants' accused organs utilized neon or glow tubes to key square or retangular tone waves, none was held to infringe plaintiff's Claim 1. Similar rulings were made with respect

[2] 35 U.S.C. § 132 provides in pertinent part that "No amendment shall introduce new matter into the disclosure of the invention."

to Claims 12 and 13. If read to be broader than Claim 1 as to the type of keyer concerned, Claims 12 and 13 were additionally held invalid under 35 U.S.C. § 121 and 37 C.F.R. § 1.141 forbidding the claiming of two or more inventions in one application.

Although Judge Will realized that his resolution of the summary judgment motion rendered the issues of laches and estoppel moot, he resolved this question as well as "an exercise of sound judicial administration." 189 USPQ at 727. Accordingly, the court also decided that the doctrine of laches foreclosed plaintiff from asserting any claims for alleged infringement prior to May 2, 1972, when notices of infringement were first served on the defendants. Finally, the court concluded that the doctrine of estoppel foreclosed plaintiff from asserting any claims against defendants for infringement of his patent. We affirm on the basis of *Muncie Gear Works, Inc., supra,* and 35 U.S.C. § 121 as implemented by 37 C.F.R. § 1.141. Therefore, we do not reach the other questions decided by Judge Will. Because summary judgment was proper on this record, there was no need for the district court to hold a jury trial as to the validity of plaintiff's patent. *Research Corp.* v. *NASCO Industries, Inc.,* 501 F.2d 358 (7th Cir. 1974); *Townsend Co.* v. *M.S.L. Industries,* 359 F.2d 814 (7th Cir. 1966).

In *Muncie Gear Works, Inc., supra,* a unanimous Supreme Court invalidated a patent on a water propulsion device. There the patentee filed a patent application on August 25, 1926, which did not suggest in any way the combination later asserted as his invention. The defendants relied on the predecessor to 35 U.S.C. § 102(b), which provided that a person shall not be entitled to the issuance of a patent if the invention was "in public use or on sale in this country for more than two years prior to his application". 315 U.S. at 766. After noting that all of the patentee's amendments filed as of December 8, 1928, like the original application, wholly failed to disclose mention of the invention later asserted under

March 30, 1929, amendments, the Court found that there was a public use or sale of the device which the claims of the patent were alleged to cover by the licensee of the patent in early 1926 and by a competitor in early 1927. Consequently, the Court invalidated the claims of the patent. Judge Will summarized the *Muncie Gear* doctrine as follows:

> "The Court concluded that, since a new application would have been statutorily barred if made more than two years after the first public use or sale of a device embodying the alleged invention, an amendment seeking to achieve indirectly what could not have been achieved directly, was improper and the patent invalid" (189 USPQ at 721).

Because the former two-year bar of 35 U.S.C. § 102(b) was reduced to one year in 1939 (53 Stat. 1212), the late claiming doctrine of *Muncie Gear* was of course correspondingly modified. See 315 U.S. at 766 n. 8.

The Faulkner patent generally concerns electronic organs which use direct current (DC) keying instead of alternating current (AC) keying. DC keying permits a smooth "attack" or "decay" of the tone signal so that the musical tone effect of "percussion" or "sustain" can be achieved as contrasted to the instantaneous sound and resultant undesirable "click" produced by AC keying. Claim 2 of Faulkner's original application, which became Claim 1 of the Faulkner patent as issued, covered "a tone signal source, a translating device, and a [neon] glow tube attenuator connected between said source and said device" in a musical instrument.[3]

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[3] The trial court's findings of fact 11-13 are set forth below as a glossary to aid in the understanding of this opinion:

> "11. The term 'rectangular wave form tone generator' in Claim 1 refers to an element which generates a rectangular wave having a particular frequency. The term 'translating device' in Claim 1

Nowhere in the original application is there any reference to anything other than neon glow tubes as keying devices. Throughout the entire six years' prosecution of the application, only neon glow tubes were disclosed as the electronic keying devices in the patent specifications. Faulkner's prototype, built from 1951 to 1956, utilized only neon glow tubes as the keying elements and it did not embody Claims 12 and 13 which Faulkner considered

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[3] (Continued)

refers to a speaker. The term 'non-linear conducting device' in Claim 1 refers to a device that is electrically coupled to the 'rectangular wave form tone generator' so as to conjunctively operate in a certain manner. The term 'bias potential' in Claim 1 refers to variable DC voltage that is applied to the non-linear conducting device. The term 'means to vary the bias potential' in Claim 1 refers to a resistance-capacitance (RC) circuit by which the magnitude of the DC voltage applied increases after the playing key (or pedal) is actuated and the magnitude of the DC voltage applied decreases when the playing key (or pedal) is released. The term 'tone signals' in Claim 1 refers to the wave generated by the tone generator. The portion of the Claim 1 circuit that includes the non-linear conducting device is generally called a 'keyer' or 'gate.'

"12. The term 'keyer' or 'DC keyer' is used in the organ art to refer to an electronic switch, while the term 'keyswitch' or 'AC keyer' is used in the organ art to refer to a mechanical switch, and transmitting a tone signal by a keyer may be called 'keying.'

"13. 'Attack' refers to the time when the playing key (or pedal) is actuated and the tone level is increasing, and 'decay' refers to the time when the playing key (or pedal) is released and the tone level is decreasing. An extended decay is known in the organ art as 'percussion' or 'sustain.'" 189 USPQ at 698.

to be auxiliary. It was scrapped by plaintiff a month before filing the first three of these lawsuits.[4]

In May 1952, plaintiff filed an amendment which again described the keying device as a "glow tube attenuator." However, in July 1954, he filed a second amendment which changed the description of the keying device from "glow tube attenuator" to "gaseous tube." This amendment was rejected by the Patent Examiner in September 1956 because "[t]here would be no invention in merely substituting a gaseous tube * * * for the diode 2 of George" patent No. 2,483,823. In an affidavit of February 22, 1975, and on earlier occasions, Faulkner agreed with the Examiner that the gaseous tube and the diode utilized as the keyer in the George patent were equivalent (Plaintiff's App. 254).

In December 1956, plaintiff filed a third amendment amending then Claim 2 to its final form, substituting, for the first time, "non-linear conducting device" for the previously described neon glow or gaseous tubes as the specified keying device. He contends that he intended both neon glow tubes and diodes to be covered by this generic substitute phrase. In general, Claim 1 in its final form relates to a circuit for DC keying tone signals to achieve percussion or sustain without frequency distortion.

In July 1955, defendant Lowrey Organ Company, subsequently purchased by defendant Chicago Musical Instrument Co. exhibited and played its Model SS organ with

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[4] The timing of the junking of the prototype is curious since Faulkner moved the organ, which weighed as much as a piano, along with his household furnishings during his various moves between 1951 and December 1972. Faulkner apparently lived in the following locations in this period: Chicago, Illinois; Torrance, Redondo Beach, and Santa Barbara, California; and West Allis and Greendale, Wisconsin, 189 USPQ at 701. Because the prototype was scrapped, the defendants were forced to construct an elaborate and expensive test circuit demonstrator for the trial.

DC keying at the National Association of Music Manufacturers (NAMM) in Chicago and again at its 1956 show in New York. This utilized a square wave tone generator keyed by a vacuum tube diode and was the first publicly exhibited electric organ to achieve desired attack, sustain and decay characteristics (artificial reverberation of musical notes to simulate pipe organ and musical instrument sounds). The Model SS organ was developed by Walter Anderson, then Lowrey's chief engineer, who obtained Patent No. 2,823,310 on it. In creating the DC-keyed Model SS organ, he employded tone generator disclosures in Langer Patent No. 2,533,821 (issued in 1950) owned by Lowrey and vacuum tube diode DC keying disclosures in George Patent No. 2,483,823 (issued in 1949) owned by the Thomas Organ Co., which has been dismissed as a defendant.[5] He was not concerned too seriously about infringing the George patent by using a diode keyer because he believed Thomas to be infringing Lowrey's Langer patent. Only the four and eight foot ranks were DC-keyed.[6] The first SS model was sold in 1957.

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[5] Anderson believed that the Faulkner "combination" as applied to diode keying was covered by George. Indeed by Faulkner's own admission:

> "the combination of the Figure 6 keying circuitry of the George patent with a rectangular wave tone generator is substantially identical to Claim 1 of the Faulkner patent. Thus, when used with a rectangular wave tone generator (as inherently suggested), the George patent in its Figure 6 embodiment teaches diode keying of signals to achieve sustain without Faulkner Distortion and thereby anticipates Faulkner's Claim 1." 189 USPQ at 704.

[6] CMI later developed an LS model, which was generally similar in structure and operation to the SS model, which could be profitably marketed at less than $1,000. This more economical version was audibly demonstrated at the July 1957 NAMM show. The "sustain" and "percussion" features were emphasized in the hand-out literature distributed at the 1957 NAMM show. While a number

Upon the foregoing uncontested facts, we hold that the *Muncie Gear* doctrine requires a determination that the Faulkner Claim 1 is invalid.[7] The third amendment of Claim 1 (then Claim 2) if made, as Faulkner insists, in December 1956 to cover not only a neon glow tube keying device but also to include any other non-linear conducting device constitutes an impermissible enlargement of the original claims, the basis for which was not disclosed therein.[8] This is because the amendment occurred more than one year after the Lowrey Model SS (upon which the enlarged claim concededly could be read (D.App. 73-74)), utilizing diode keying of square waves, was first put into public use by virtue of its July 1955 public demonstration at the Chicago show of the National Association of Music Manufacturers. When that model was played, a visitor to the trade show could hear per-

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[6] (Continued)

of square wave tone generators were used on the LS model, most were not DC-keyed. The entire lower manual as well as the 16 foot and quint ranks were all AC-keyed. Only the four and eight foot ranks were DC-keyed. The "LS insofar as the sustain circuitry is concerned was identical to the SS • • •" (D. App. 86).

[7] Claim 1 provides:

> "1. In a musical instrument, a rectangular waveform tone generator, a translating device, a non-linear conducting device connected between said tone generator and said translating device, a source of bias potential for said non-linear conducting device, means for causing said bias potential to vary in a continuous manner, said conducting device being operated by said variation of said bias potential to control the amplitude of tone signals transmitted from the tone generator to the translating device, said rectangular waveform preventing frequency distortion of the tone signals despite the non-linear characteristic of said conducting device."

[8] See *Chicopee Manufacturing Corp.* v. *Kendall Co.*, 288 F.2d 719, 723-724 (4th Cir. 1961).

cussion notes fading away after keys are released, suggesting "reverberation" or the slow decay of a tone signal, thus revealing some DC keying.

Indeed, at the trial, plaintiff did not dispute Anderson's testimony about the circuitry of the SS organ displayed at the 1955 show. Anderson explicitly stated that the Model SS introduced at the 1955 show had DC keying. Plaintiff tries to introduce a question of fact on whether the SS model at the 1955 show actually had DC keying as Faulkner concedes the 1957 production model did (D. App. 73-74). In a report by Hammond engineer Alan Young on the SS model demonstrated at the 1956 NAMM show, he indicated that "Percussion notes fade away after keys are released, suggesting reverberation." Some AC keying circuits can give the impression of sustain. 189 USPQ at 716. In a chart appended to this report, Young indicated his opinion that the organ had AC keying. In a similar report on the 1957 NAMM show, Young states:

> "The *Lincolnwood,* costing $1,695.00 became available this year and is the experimental model shown at the two previous Shows. It contains the same generator system, but the keying is improved to D.C.-keying, which eliminates key click and makes possible slow decay percussion after keys are released." (P. App. 364)

This apparent inconsistency can be resolved when it is recalled that only a minority of the tone generators in the SS organ were DC keyed. Thus it is possible that Young only heard AC keyed sounds while viewing the SS model. Indeed, next to the column labeled "keying circuit," Young placed a notation (in the row of the chart describing the characteristics of the SS organ) which appears to read "Pedal Rail." Since the pedal tones of the SS model were AC-keyed, note 6 *supra,* this notation impeaches the document's conclusion that *all* of the tone generators in the organ were AC-keyed. The chart also declares that the Model SS had a "Decay after key release," a phrase usually indicative of DC keying.

In any event, Faulkner never attempted to contest Anderson's testimony during the estoppel trial that the SS model displayed in the 1955 show did have DC keying. Such a contest would have been relevant to the early commercial activity in the field by Lowrey, and hence would have been relevant to the ultimate trial issues of laches and estoppel. Moreover, in its February 28, 1975, opposition to defendants' summary judgment motion, plaintiff offered only the following conclusory statements:

> "As the record in this case presently stands, there is no reliable evidence as to what CMI's [then Lowrey's] 'SS' organ embodied.
>
> • • • • •
>
> "Further, there is a genuine issue of material fact as to whether any item designated as a 'Model SS' contained non-linear DC-keying of square waves at any critical date."

Because defendants' motion was supported by Anderson's unchallenged testimony, the plaintiff was obliged to provide affidavits or other evidentiary vehicles to set forth specific facts showing a genuine issue of whether the SS model shown in 1955 was DC-keyed. This the plaintiff failed to do. As a result, summary judgment was proper. Rule 56(e), Federal Rules of Civil Procedure. Plaintiff did not point to any "specific facts" required by Rule 56(e) until he highlighted the Young report to us. Since the Young report was not referenced in plaintiff's opposition to defendants' motion for summary judgment, the trial court's entry of summary judgment may not be disturbed. *Southern Rambler Sales, Inc.* v. *American Motors Corp.,* 375 F.2d 932, 937 (5th Cir. 1967). ("Meet these affidavit facts or judicially die.")

Plaintiff's charge in a letter of June 20, 1972, repeated in his deposition, that the SS organ infringed his patent belies his present assertion that the Lowrey instrument did not employ any DC keying or rectangular waveform generating means. Although he has accused defendant Lowrey of infringing his patent through its Model SS

organ, he could not have done so before his 1956 amendment broadened his claim, for a "glow tube" does not describe or encompass a "diode" but, according to plaintiff, "non-linear conducting device" (used in the December 1956 amendment) does. None of the accused organs used the neon glow tubes of Faulkner's prototype but instead used other non-linear conducting devices to key square tone waves.

In claiming that the accused organs violated his patent, plaintiff necessarily relies on the phrase "non-linear conducing device" introduced in his third amendment of December 1956. If Claim 1 is to be read broadly to cover all forms of non-linear conducting devices,[9] it includes

[9] The patent itself contains internal evidence of inconsistency:

> "Every claim, other than Claim 1, still refers either to a 'glow tube' (Claims 2, 3 and 6), a 'gaseous tube' (Claims 4, and 5), a 'keyer,' 'keyers' or 'electronic keyers' (Claims 9, 10, 12, 13 and 14), or makes no reference to a keying device at all. No claim refers to a vacuum tube diode much less to a solid state diode or transistor all of which Faulkner now insists are covered by his Claim 1.
>
> "Moreover, in describing the keyer, the patent (col. 4, line 56, through cols. 5, 6 and 7, line 58) speaks repeatedly and only of glow tubes, keyer glow tubes or keyer tubes. Nowhere is there any reference to any other DC keying device. On the contrary, the patent describes the keyer as follows (col. 4, lines 58-62):
>
> > "In general, the keyer consists of a *glow tube* connected between a tone source and a load circuit together with circuit arrangements for impressing a variable bias voltage on the *glow tube*. (underscoring supplied in original)"
>
> 189 USPQ at 723.

This and other evidence caused the district court to state: "We believe • • • that all of the evidence points unequivocally to the conclusion that the Faulkner patent is limited to the use of glow tubes to key square waves," *Id.*

the vacuum tube diode keyer first put into public use by Lowrey in July 1955 at the Chicago show. Since this was more than a year before plaintiff's third amendment, Claim 1 of the Faulkner patent is invalid under the "late claiming" doctrine of *Muncie Gear* because an amendment may not accomplish what a new application is not permitted to accomplish under the one-year bar of 35 U.S.C. § 102(b). The public exhibit and demonstration of the Lowrey Model SS at the Chicago show, regardless of a Hammond Organ employee's description of it as experimental, satisfies the term "public use" as used in *Muncie Gear* and 35 U.S.C. § 102(b). *Cloud* v. *Standard Packaging Corp.*, 376 F.2d 384, 389-390 (7th Cir. 1967).[10]

---

[9] (Continued)

Because we choose not to reach estoppel issues, we do not decide whether Faulkner should be estopped from denying that he always intended his patent to include only neon glow tubes.

[10] Young's 1956 report also stated that the new model, shown for the second year, "is promised for release by the first of next year" (P. App. 361). Neither the fact that the Lowrey organ was not available for sale to customers until May 1957 nor Hammond's characterization for the SS model as "experimental" makes the 1955 showing "experimental" in the technical sense of a non-public use. In this Circuit, commercial exploitation at a trade fair is not "experimental" in this sense because it is "not naturally incident to • • • the purpose of testing the qualities of the invention." *Cloud, supra,* 376 F.2d at 390. See also *Electric Storage Battery Co.* v. *Shimadzu,* 307 U.S. 5, 20; *Magnetics, Inc.* v. *Arnold Engineering Co.,* 438 F.2d 72 (7th Cir. 1971); *Kardulas* v. *Florida Machine Products Co.,* 438 F.2d 1118, 1123-1124 (5th Cir. 1971); *Koehring Co.* v. *National Automatic Tool Co.,* 362 F.2d 100, 103 (7th Cir. 1966); *Atlas* v. *Eastern Air Lines, Inc.,* 311 F.2d 156, 159-160, 161-162 (1st Cir. 1962); *Connecticut Valley Enterprises, Inc.* v. *United States,* 348 F.2d 949, 952 (Ct. Cl. 1965).

As Judge Will held, since the "keyer" referred to in Claims 12 and 13,[11] is the keyer of Claim 1, those claims, which are dependent on Claim 1, are invalid under *Muncie Gear* if read to include any keyers using non-linear conducting devices. Plaintiff asserts that the three claims in issue "are for different combinations and have different scope" (Br. 15). He, therefore, suggests that the "electronic keyer" referred to in Claims 12 and 13 includes devices other than the "non-linear conducting device" of Claim 1. This argument is blatantly specious and "not in our opinion tenable" (189 USPQ at 726) when

[11] Claims 12 and 13 provide:

"12. In a musical instrument, a set of tone generators for producing signals at frequencies corresponding to the notes of the musical scale, a plurality of signal channels, an electronic keyer connected between each of said generators and each of said signal channels, a common biasing means for simultaneously operating a plurality of said keyers, a translating device, and registration controls connecting said signal channels to said translating device.

"13. In a musical instrument, a set of tone generators for producing signals at frequencies corresponding to the notes of the musical scale, a plurality of signal channels having different transmission characteristics, an electronic keyer connected between each of said generators and each of said signal channels, a common biasing means for simultaneously operating a plurality of said keyers, a translating device, and registration controls connecting said signal channnels to said translating device."

Plaintiff states that Claim 13 differs from Claim 12 "only in that the signal channels are specified as 'having different trasmission characteristics'" (Br. 16). It is dependent on Claim 12 since it incorporates all of that claim's elements. No licenses under Claims, 1, 12 or 13 have ever been granted in the electronic musical instrument field.

viewed in the light of the patent specifications.[12] *United States* v. *Adams*, 383 U.S. 39, 49. The patent clearly states that the disclosed keyer is the gist of the "invention":

> "As the keyer is regarded as the most important element of the invention, its operation will be described first" (App. 228).

The patent goes on to give two explicit "embodiments" of the keyer (App. 229-230). At best the patent claims a generic class of keyers and the patent describes two specific glow tube variants. Even if the generic class of claimed keyers is assumed to include variants not embodying glow tube components (which is a highly dubious assumption), the term "electronic keyer" in Claims 12 and 13 does not have a different meaning than the described keyer in Claim 1. Indeed, the patent itself discloses that:

> "it is the aim of the appended claims to include all such variations and modifications as fall within the true spirit and scope of the invention" (App. 225).

[12] 35 U.S.C. § 121 states that the "validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention." Thus if it is manifest that a single issued patent claims two or more independent and distinct inventions, the patent would be valid assuming it was free of other defects.

However, 35 U.S.C. § 121 also provides that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." By way of 37 C.F.R. § 1.141 (35 U.S.C.A. App. 1 at 690), the Commissioner has made this requirement mandatory. Thus if a claim is ambiguous, *i.e.*, capable of being read as an independent and distinct invention or just another claim of one invention, the statute and regulation together create a presumption against reading the claim as an independent and distinct invention.

By cross-appeal, defendants insist that they were entitled to recover attorney's fees under 35 U.S.C. § 285, which provides that a court "in exceptional cases" may award reasonable attorney's fees to the prevailing party. Thirty-eight volumes of testimony were taken over a period of 35 days before the long-experienced trial judge. After listening to the testimony and reviewing the voluminous documentary evidence in preparation for his findings of fact, conclusions of law and opinion, Judge Will refused to consider the case "exceptional" and therefore did not award attorney's fees to defendants. Because of the facial breadth of the claims in issue, we cannot say that plaintiff's suits were harassive and extortive. If Judge Will had concluded that Faulkner's conduct was unconscionable and deceptive, he would have granted defendants' request for attorney's fees. Instead, he did not find that this consolidated lawsuit was prosecuted in bad faith. In fact, from his testimony, Judge Will "thought he [plaintiff] was a straight-forward fellow" (April 16, 1976, Tr. 21).

In *H. K. Porter Co.* v. *Black & Decker Manufacturing Co.*, 518 F.2d 1177, 1178-1179 (7th Cir. 1975), we recently determined that attorney's fees are only awarded in this Circuit in exceptional patent cases to prevent gross injustice where fraud and wrongdoing are clearly proved. The court below found no gross injustice, nor did it find that defendants had proved fraud and wrongdoing by plaintiff. Since defendants have not shown that the district judge abused his sound discretion in not allowing them attorney's fees, his disposition of the matter will not be disturbed here. *Rockwell* v. *Midland-Ross Corp.*, 438 F.2d 645, 655 (7th Cir. 1971).

As defendants' reply brief as cross-appellants has reminded us,

> "The District Court presided over pre-trial discovery for two years; held evidentiary hearings on 35 days over a period of a year; and had ample opportunity to evaluate the demeanor of Mr. Faulkner and many other witnesses. Hundreds of documentary and physical exhibits were received in evidence. Organs were played. Demonstrations were made. Experts testified. Additional hundreds of pages of briefs were submitted by counsel for the assistance of the District Court." (Reply Br. 1-2)

In such circumstances, the district court was in the best possible position to assess attorney's fees against plaintiff if it deemed it suitable to do so. Similarly, we have had to study lengthy briefs and a voluminous record before deciding this case. Like the district court, we do not view it as the kind of case where attorney's fees should be awarded to defendants on the basis of the posture of their appeal.

JUDGMENTS AFFIRMED.[13]

[13] Plaintiff's April 19, 1977, motion for an order "to remove from this Court's files, and to excise or otherwise obliterate pages 176 through 188 from the defendants' Appendix," which purport to show that plaintiff's counsel specifically asked for a "separate non-jury trial on [laches and estoppel] prior to trial on the issues of validity and infringement" (D. App. 177), is denied.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit

Chicago, Illinois 60604

October 11, 1977

Before

Hon. WALTER J. CUMMINGS, *Circuit Judge*
Hon. WILBUR F. PELL, JR, *Circuit Judge*
Hon. MYRON L. GORDON, *District Judge*•

ALFRED H. FAULKNER, Plaintiff-Appellant, Cross-Appellee, Nos. 76-1588 - 76-1596 vs. BALDWIN PIANO & ORGAN CO., et al., Defendants-Appellees, Cross-Appellants.	Appeals from the United States District Court for the Northern District of Illinois, Eastern Division. Nos. 73C 136, 139, 140, 793 and 794. HUBERT L. WILL *Judge.*

ORDER

On consideration of the petition for rehearing and answer thereto, the slip opinion is modified as follows:

On page 3, strike "additionally" in the third from last line of the second paragraph.
On page 12, change the opening sentence of paragraph one to read as follows:

> "As Judge Will held since the 'keyer' referred to in Claims 12 and 13[11] is the keyer of Claim 1, those claims are invalid if read to include any and all keyers using non-linear conducting devices."

• District Judge Myron L. Gordon of the Eastern District of Wisconsin is sitting by designation.

No member of the panel and no judge in regular active service having requested that a vote be taken on the suggestion for an *en banc* rehearing, and the panel having voted to deny a rehearing,

It Is Ordered that the petition of the appellant for a rehearing is denied.

CONSTITUTION OF THE UNITED STATES
AMENDMENT VII—CIVIL TRIALS

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

FEDERAL RULES OF CIVIL PROCEDURE

Rule 38.

JURY TRIAL OF RIGHT

(a) Right Preserved. The right of trial by jury as declared by the Seventh Amendment to the Constitution or as given by a statute of the United States shall be preserved to the parties inviolate.

(b) Demand. Any party may demand a trial by jury of any issue triable of right by a jury by serving upon the other parties a demand therefor in writing at any time after the commencement of the action and not later than 10 days after the service of the last pleading directed to such issue. Such demand may be indorsed upon a pleading of the party.

(c) Same: Specification of Issues. In his demand a party may specify the issues which he wishes so tried; otherwise he shall be deemed to have demanded trial by jury for all the issues so triable. If he has demanded trial by jury for only some of the issues, any other party within 10 days after service of the demand or such lesser time as the court may order, may serve a demand for

trial by jury of any other or of the issues of fact in the action.

(d) Waiver. The failure of a party to serve a demand as required by this rule and to file it as required by Rule 5(d) constitutes a waiver by him of trial by jury. A demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties.

(e) Admiralty and Maritime Claims. These rules shall not be construed to create a right to trial by jury of the issues in an admiralty or maritime claim within the meaning of Rule 9(h).

As amended Feb. 28, 1966, eff. July 1, 1966.

1966 Amendment

Added subdivision (e).

Rule 39.

TRIAL BY JURY OR BY THE COURT

(a) By Jury. When trial by jury has been demanded as provided in Rule 38, the action shall be designated upon the docket as a jury action. The trial of all issues so demanded shall be by jury, unless (1) the parties or their attorneys of record, by written stipulation filed with the court or by an oral stipulation made in open court and entered in the record, consent to trial by the court sitting without a jury or (2) the court upon motion or of its own initiative finds that a right of trial by jury of some or all of those issues does not exist under the Constitution or statutes of the United States.

(b) By the Court. Issues not demanded for trial by jury as provided in Rule 38 shall be tried by the court; but, notwithstanding the failure of a party to demand a jury in an action in which such a demand might have been made of right, the court in its discretion upon motion may order a trial by a jury of any or all issues.

(c) Advisory Jury and Trial by Consent. In all actions not triable of right by a jury the court upon motion or of its own initiative may try any issue with an advisory jury or, except in actions against the United States when a statute of the United States provides for trial without a jury, the court, with the consent of both parties, may order a trial with a jury whose verdict has the same effect as if tfial by jury had been a matter of right.

Rule 42.

CONSOLIDATION; SEPARATE TRIALS

(a) Consolidation. When actions involving a common question of law or fact are pending before the court, it may order a joint hearing or trial of any or all the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.

(b) Separate Trials. The court, in furtherance of convenience or to avoid prejudice, or when separate trials will be conducive to expedition and economy, may order a separate trial of any claim, cross-claim, counterclaim, or third-party claim, or of any separate issue or of any number of claims, cross-claims, counterclaims, third-party claims, or issues, always preserving inviolate the right of trial by jury as declared by the Seventh Amendment to the Constitution or as given by a statute of the United States.

As amended Feb. 28, 1966, eff. July 1, 1966.

Rule 56.

SUMMARY JUDGMENT

(a) For Claimant. A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the expiration of 20 days from the commencement of the action or after

service of a motion for summary judgment by the adverse party, move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof.

(b) For Defending Party. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

(c) Motion and Proceedings Thereon. The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages.

(d) Case Not Fully Adjudicated on Motion. If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court at the hearing of the motion, by examining the pleadings and the evidence before it and by interrogating counsel, shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, including the extent to which the amount of damages or other relief is not in controversy, and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) Form of Affidavits; Further Testimony; Defense Required. Supporting and opposing affidavits shall be made

on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleading, but his response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If he does not so respond, summary judgment, if appropriate, shall be entered against him.

(f) When Affidavits are Unavailable. Should it appear from the affidavits of a party opposing the motion that he cannot for reasons stated present by affidavit facts essential to justify his opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

(g) Affidavits Made in Bad Faith. Should it appear to the satisfaction of the court at any time that any of the affidavits presented pursuant to this rule are presented in bad faith or solely for the purpose of delay, the court shall forthwith order the party employing them to pay to the other party the amount of the reasonable expenses which the filing of the affidavits caused him to incur, including reasonable attorney's fees, and any offending party or attorney may be adjudged guilty of contempt.

As amended Dec. 27, 1946, eff. March 19, 1948; Jan. 21, 1963, eff. July 1, 1963.

UNITED STATES CODE: TITLE 35

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. July 19, 1952, c. 950, § 1, 66 Stat. 797.

§ 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention. July 19, 1952, c. 950, § 1, 66 Stat. 800.

§ 282. Presumption of validity; defenses

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement, or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires. (Amended July 24, 1965, Public Law 89-83, sec. 10, 79 Stat. 261.)

CODE OF FEDERAL REGULATIONS: TITLE 37

(Rules Promulgated by Commissioner of Patents & Trademarks)

§ 1.141 Different inventions in one application

Two or more independent and distinct inventions may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to each species in excess of one written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Supreme Court, U. S.
FILED
1978
MICHAEL RODAK, JR., CLERK

No. 77-973

IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

ALFRED H. FAULKNER,

Petitioner,

vs.

BALDWIN PIANO & ORGAN CO., CHICAGO MUSICAL INSTRUMENT CO. et al., THE WURLITZER COMPANY et al., HAMMOND CORP. et al., and L & G ENTERPRISES, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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42 F.R.C.P. 4, 5
56 F.R.C.P. 17, 18
37 C.F.R. §1.141 ..... 9, 21
35 U.S.C.A. 21
Supreme Court Rule 19 ..... 1, 25

IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

ALFRED H. FAULKNER,

Petitioner,

vs.

BALDWIN PIANO & ORGAN CO., CHICAGO MUSICAL INSTRUMENT CO. et al., THE WURLITZER COMPANY et al., HAMMOND CORP. et al., and L & G ENTERPRISES, INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Introduction

Respondents respectfully submit that the Petition sets forth no special or important matter warranting review by this Court.

Petitioner has attempted to invoke Supreme Court Rule 19 on account of alleged conflicts in the circuits or between the Seventh Circuit Court of Appeals and this Court. No such conflicts exist.

Moreover, the present case is an ordinary patent infringement action, involving a dispute between private parties, exceptional only in that Petitioner delayed any assertion of his rights until the waning years of his patent. The sole patent in suit expired October 29, 1974. There has been no other litigation of this patent. The questions raised by Petitioner involve only the private interests of the litigants, and there is no question of widespread or general public interest whatsoever.

The action was resolved favorably to the Respondents by the District Court after 35 days of trial directed to laches and estoppel issues and after a subsequent and alternative Motion for Summary Judgment directed to the merits of Petitioner's patent. The District Court issued a comprehensive opinion that included 219 findings of fact and 16 conclusions of law. This resolution was affirmed by the Seventh Circuit Court of Appeals in a unanimous opinion written by Judge Cummings.*

The Petition does nothing more than argue for yet another level of appeal, seeking a *de novo* review of the scope and validity of the patent in suit, in the hope that this Court will reach a different conclusion than the District Court and Court of Appeals. Chief Justice Taft in *Magnum Co. v. Coty*, 262 U.S. 159, 163 (1923), appropriately stated:

> The jurisdiction [of the Supreme Court to review cases by way of certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing.

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* The appellate opinion found it unnecessary to reach the alternative basis for the District Court's judgment in favor of Respondents, namely, the adjudication after trial of the issues of laches and estoppel.

Counterstatement of Questions Presented

The "Questions Presented" by Petitioner reflect gross misconstructions of the record. The essential issues on which Petitioner seeks this Court's intervention may be properly stated as:

(1) Is it a denial of due process to grant summary judgment of non-infringement or invalidity of Petitioner's patent as a matter of law when such judgment happened to be preceded by a bench trial of laches and estoppel issues, when such bench trial was affirmatively sought by Petitioner himself, and when Petitioner waived any possible claim to a jury trial of the laches and estoppel issues?

(2) Is reading a patent claim in the light of the patent specifications, *U.S. v. Adams*, 383 U.S. 39, 49 (1966), an impermissible attempt to limit the claim, or is it instead a proper means for interpreting the claim as a matter of law?

(3) Is summary judgment of non-infringement or invalidity proper in a patent infringement case, despite a request for jury trial of those issues, when there are no genuine factual issues to be resolved by a jury and when Petitioner belatedly asserted an alleged existence of the possibility of a fact inference favorable to his view of the case?

(4) Should this Court review the Court of Appeals' unanimous affirmance of the District Court's application of the unambiguous and consistently construed holding in *Muncie Gear v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759 (1941), to the effect that a patentee may not achieve indirectly by amendment of claims what could not have been achieved directly with a new application, namely, patent coverage of a device in "public use" more than a year prior to the amendment?

Supplemental Statement of the Case

Petitioner's argumentative statement of the case distorts, omits, and inadequately sets forth the relevant facts. For the sake of brevity, but consistent with providing this Court with an accurate version of the proceedings below, Respondents will expose only the most glaring of Petitioner's distortions.

The Court of Appeals aptly describes the patented subject matter and accurately relates the circumstances underlying application of the *Muncie Gear* "late claiming" doctrine to this case (App. 2a-13a). Respondents need not, therefore, repeat here the technological aspects of the case or the circumstances surrounding "prior use" of Petitioner's alleged invention.

Petitioner's patent-in-suit issued on October 29, 1957, from an application filed March 3, 1951, and relates to circuitry utilized in electronic musical organs. The present case is a typical patent infringement action, extraordinary only in that Petitioner delayed until after virtually the entire electronic organ industry openly adopted the accused circuitry before filing suit against the alleged infringers in 1973.

Each of the Respondents asserted the affirmative defenses of laches and estoppel against Petitioner's belated suits, which were consolidated for discovery and trial before Judge Will. Petitioner correctly notes that it was his own suggestion at an initial pretrial conference that "a separate and prior trial of the affirmative defenses of laches and estoppel be had under Rule 42

F.R.Civ.Proc." (Pet. p. 5). However, Petitioner neglects to reveal that he himself conceded from the very inception that this trial would be a bench trial, despite his request for a jury on the ultimate merits. Thus, at the pretrial conference, Petitioner's counsel produced a written "Motion for Separate and Prior Trial Under Rule 42(b) F.R.C.P.". Significantly, this Motion stated:

> The affirmative related defenses of "laches", "acquiescence" and "estoppel" are matters in equity that are to be decided by a judge.*

The formal filing of this Motion by Petitioner was rendered moot by the agreement of all parties, including Petitioner and the Court, to the separate, initial bench-trial on the issues of laches and estoppel as requested by Petitioner. Reference to the Motion requesting this separate non-jury trial appears in a "Statement of Proceedings Submitted Pursuant to Rule 10(c) F.R.A.P.", which reads in part:

> 4. Based upon Mr. Lettvin's [Petitioner's Counsel] request and the agreement of Defense Counsel, Judge Will agreed to hold such a separate non-jury trial. . . (SA 177)**

All of the parties thereafter conducted themselves in accordance with the understanding reached at this pretrial conference and prepared for a non-jury trial on the issues of laches and estoppel. However, during subsequent discovery, key facts were brought out which proved the incredibility of Petitioner's asserted "lack of knowledge" defense on the issues of laches and estoppel.

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* The Motion in question is attached as Exhibit C to a "Response to Appellant's Motion for Order to Remove and Excise Materials". The aforesaid "Appellant's Motion" was expressly *denied* by the Court of Appeals (footnote at App. 17a).

** The notation "SA" refers to the Defendant's Appendix Accompanying Brief of Defendant-Appellees filed with the Court of Appeals.

Consequently, Petitioner moved to strike the laches defenses of the Respondents (CA 92-6)* on the basis that as a matter of law laches and estoppel defenses are not applicable to a patent infringement action. Even then, Petitioner did not maintain that he was being deprived of a jury trial.

Before proceeding with the hearing of evidence at the initial bench trial on June 26, 1973, the District Court specifically considered and denied Petitioner's pretrial motion to strike the Respondents' laches defense (CA 109-13). Without further objection, Petitioner proceeded with the bench trial at that first hearing. His participation was complete, and Petitioner at no time complained of any alleged denial of a jury trial. However, the hearings initiated on June 26, 1973 were recessed on June 27, 1973 by the District Court because the Court recognized the necessity of the parties' engaging in further discovery and completing a Pre-Trial Order before resumption of trial in order to conserve judicial time.

Significantly, in the process of terminating the initial abortive hearing on laches and estoppel, the District Court announced an intention upon resumption of trial to proceed with the whole case without an initial separation of issues, despite the previously outlined wishes of all parties (Petitioner, Respondents, and the Court itself) to try laches and estoppel on a threshold basis by bench trial. Respondents asked whether the Court would reconsider and entertain a joint request for a preliminary bench hearing on the question of laches and estoppel (CA 144). In the colloquy which followed, the Court was reminded that a composite trial would be

* The notation "CA" refers to the Common Appendix filed with the Court of Appeals.

complicated by the Court's necessity to decide the equitable defenses of laches and estoppel (factually and legally) and by the jury's necessity to decide the ultimate factual merits, if anything factual remained to be decided (CA 145).

In this context, counsel for one of the Respondents stated:

> The plaintiff has waived a jury demand as far as the laches issue is concerned (CA 146).

Petitioner's counsel voiced no objection and acquiesced in this self-evident proposition. As a matter of fact, Petitioner's counsel, referring to the possibility of an adverse ruling on the issues of laches and estoppel, stated:

> Your Honor, your evaluation and analysis of the alternatives available to you, pointed out that there is only one alternative that would take it [*i.e.*, the ultimate merits] away from the jury (CA 147).

The District court thereafter stated as follows:

> That is why I concluded a half hour or more ago that there wasn't any sense to having a separate trial on the issues of validity and infringement from the trial on the issues of laches, until [one of the defendants' counsel] pointed out that the issue of laches was going to be tried necessarily by the Court, but the issues of validity and infringement were going to be tried in this case by the jury.
>
> Well, that is a different ball game. I don't know where that leaves me. I would have to scratch my head about it a little bit, but it does seem to me if I try the issue of laches properly, I am going to get an awful lot of evidence which is also relevant to validity and infringement, and which is going to have to be presented over again at a subsequent trial if I don't conclude that laches or estoppel, or both, or in part at least, are applicable to the plaintiff (CA 152-3).

Thereafter, Petitioner's counsel specifically admitted:

> I agree with the court that the decision on laches and estoppel, the ultimate decision, is the court's only and not the jury's (CA 153-4).

Obviously, Petitioner still was not asserting that he was being denied any right to a jury trial.

As noted by Petitioner, the District Court ultimately reconsidered and adhered to the original approach of a separate laches and estoppel bench trial (Pet. p. 6), but still Petitioner did not contend that any right to a jury trial was being abrogated. The laches and estoppel trial commenced on June 3, 1974, continued intermittently for 35 days through November 6, 1974, and involved 24 witnesses and hundreds of documentary and physical exhibits. Following the conclusion of this extended trial, Respondents filed a timely Motion for Summary Judgment on the ground that uncontested facts established the invalidity of Petitioner's patent. Briefs on the issues of laches and estoppel and on the alternative issues of summary judgment were filed by both sides. No mention was ever made by Petitioner of having been denied a jury trial on the issues tried by the Court.

Subsequently the District Court entered a judgment for Respondents on the issues of laches and estoppel as well as on certain (but not all) issues raised in the Motion for Summary Judgment. The District Court entered 219 findings of fact and 16 conclusions of law, together with a comprehensive opinion (189 U.S.P.Q. 695-732) granting summary judgment and holding that Petitioner's complaint must be dismissed with prejudice and with costs to Respondents. The District Court also found Petitioner guilty of laches and estoppel for his failure to assert his rights against anyone for almost fifteen (15) years. In its conclusions of law, the Court held that summary judgment was appropriate on

certain validity issues as to Claims 1, 12, and 13 of the patent in suit "since the prior art, history of the prosecution of the application leading to the issuance of the patent and the patent itself are all documents capable of interpretation upon examination and all other facts relevant to validity are undisputed" (189 U.S.P.Q. at 716). The gist of these rulings was that Petitioner's patent claims had to be limited to glow tube keyers (not used by any Respondents) in order to preserve their validity.

The District Court held that Claim 1, if interpreted to cover more than glow tube keyers, would be invalid under the "late claiming" doctrine of *Muncie Gear Works, Inc., v. Outboard Marine & Manufacturing Co.*, 315 U.S. 759 (1941). Analogously, the District Court determined that Claims 12 and 13, like Claim 1, must be construed as limited to glow tube keyers because of the patent specification, file wrapper history, and the provisions of 35 U.S.C. § 121 and C.F.R. § 1.141.

Respondents had sought summary judgment of invalidity precisely because Petitioner had sought to expand his patent to cover more than glow tube keyers. The District Court agreed that such expansion would invalidate each of Claims 1, 12, and 13 (for differing reasons, in part, as to Claim 1 versus Claims 12 and 13), and thus ruled in the alternative that the claims were valid, but not infringed, if read narrowly and invalid if read broadly. This was not a *sua sponte* ruling on bases not requested. To the contrary, it was a precise recognition of the very grounds of invalidity asserted by Respondents. The alternative of limiting the claims to avoid infringement was merely an inherently logical extension of Respondents' position regarding invalidity.

Petitioner urged before the Court of Appeals the same issue of denial of a jury trial that he urges in his Petition. Respondents answered before the Court of Appeals (1) that Petitioner was not entitled to a jury trial on the equitable issues of laches and estoppel and had in any event waived any claim to a jury trial by his own initiation of and participation in a bench trial of those issues, and (2) that Petitioner was not entitled to a jury trial on the merits of his patent because there were no factual issues to be determined by a jury. The Court of Appeals ruled that "[b]ecause summary judgment was proper on this record, there was no need for the district court to hold a jury trial as to the validity of plaintiff's patent" (App. 4a). In view of this affirming ruling, there was no need to "reach the other questions decided by Judge Will" (App. 4a).

ARGUMENT

REASONS FOR DENYING THE WRIT

I. AS TO THE FIRST AND THIRD QUESTIONS

Petitioner's First and Third Questions are essentially two sides of the same coin. In posing his First Question, Petitioner erroneously contends that he was denied due process and improperly denied a jury trial of legal issues by the District Court's granting, and the Court of Appeals' affirmance, of summary judgment in Respondents' favor. Petitioner's Third Question simply raises the same issue from a different perspective, arguing that the award of summary judgment was improper because there was a fact question as to whether the possibility of an inference favorable to Petitioner's view of the case exists. Because these two questions are inextricably intertwined, Respondents will treat them together.

In posing his First Question, Petitioner erroneously contends that affirmance of summary judgment by the Court of Appeals constitutes a direct conflict with the decisions by this Court in *Beacon Theatres v. Westover*, 359 U.S. 500 (1960), and *Dairy Queen v. Wood*, 369 U.S. 469 (1962). Petitioner is fundamentally wrong. He is seeking only to create a basis for further appellate review by arguing that there is a "conflict" when, in reality, no such conflict exists.

Petitioner correctly notes that *Beacon Theatres* and *Dairy Queen* stand for the proposition that a right to a jury trial of legal issues cannot be lost through a prior determination of equitable issues (Pet. p. 11). However, Petitioner has not lost any "right" to a jury trial by the

District Court's determination of the equitable defenses of laches and estoppel. Simply stated, Petitioner is not entitled to a jury trial of the non-infringement or invalidity issues because of the absence of any genuine factual issues to be resolved by the jury, and not because of the District Court's determination of the alternative laches and estoppel issues. In short, Petitioner was not entitled to a jury trial regarding non-infringement and invalidity regardless of whether the laches and estoppel issues were decided, regardless of by whom they were decided, and regardless of how they were decided.

Moreover, neither *Beacon Theatres* nor *Dairy Queen* involved a motion for summary judgment and thus are not controlling. Petitioner's criticism notwithstanding (Pet. pp. 12-3), the Court of Appeals obviously recognized that no useful purpose would be served by citing or discussing these Supreme Court decisions because their rationale is inapplicable to the factual circumstances and procedural history of the instant case.

It has long been settled that the grant of summary judgment does not infringe a party's constitutional right to a trial by jury. *Fidelity & Deposit Co. v. United States*, 187 U.S. 315, 320 (1902). In *King v. United Benefit Fire Insurance Company*, 377 F.2d 728, 731 (10th. Cir. 1967), the Court stated the rule clearly as follows:

> It is firmly established that the granting of a motion for summary judgment or directed verdict in an appropriate case does not infringe upon the right to trial by jury.

The record discloses that the District Court construed and interpreted Petitioner's patent *as a matter of law* based on *uncontroverted facts*—a procedure entirely consonant with the Seventh Amendment and with the

provisions of Rule 39(a), F.R.Civ.P.* As aptly stated by Mr. Justice Brandeis in *Ex Parte Peterson*, 253 U.S. 300, 310 (1920):

> No one is entitled in a civil case to trial by jury unless and except so far as there are issues of fact to be determined.

The case of *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co.*, 332 F.2d 406 (6th Cir. 1964), is pertinent in view of Petitioner's misguided reliance upon the *Beacon Theatres* and *Dairy Queen* decisions. Defendant's motion to strike the plaintiff's jury demand therein was granted by the District Court. The District Court subsequently held both patents invalid. 204 F.Supp. 249 (W.D. Tenn. 1961). Plaintiff appealed and the Court of Appeals vacated the judgment and remanded the case for reconsideration in light of the *Dairy Queen* case, which had just been decided by this Court. See 305 F.2d 375 (6th Cir. 1962). On remand, the District Court held that the patents were invalid as a matter of law in view of the undisputed evidence and that therefore no prejudice accrued to the plaintiff in striking the demand for a jury trial, 214 F.Supp. 704 (W.D. Tenn. 1963).** The Court of Appeals affirmed:

> Throughout our disposition of this case we have not been unmindful of plaintiff's right to a jury trial. We are of the opinion, however, that the facts were

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* Rule 39(a) specifically provides that when a trial by jury has been demanded, the trial of all issues so demanded shall be by jury in the absence of stipulation or unless ". . . the court upon motion or of its own initiative finds that a right of trial by jury of some or all of those issues does not exist . . ."

** The Court concluded, *inter alia*, that the claims were invalid on the authority of *Muncie Gear, supra*, and that "no factual dispute needed resolution for the court to conclude as a matter of law that the three claims herein were invalid," 214 F.Supp. at 706-7.

> clearly established and that there were no factual issues to be resolved by a jury. Therefore plaintiff was not prejudiced by the denial of a jury trial. (332 F.2d at 417)*

Plaintiff's subsequent petition for writ of certiorari was denied by this Court, 379 U.S. 888 (1964). The perceptive rationale of the *Monroe* case is dispositive of the First Question advanced by Petitioner.

In the instant case, Petitioner requested a preliminary non-jury trial on the issues of laches and estoppel. The Respondents agreed, the trial was held, and the decision was unfavorable to the Petitioner. Prior to this decision, Respondents also moved in the alternative for summary judgment. At the same time the laches and estoppel issues were decided adversely to Petitioner, the alternative of summary judgment was granted by the District Court after determining that there were no disputed questions as to any material facts.** Petitioner now asserts he was denied his constitutional right to a jury trial. It is undisputed, however, that he himself requested a non-jury trial on the laches and estoppel issues resolved against him, and he simply was not entitled to a jury trial as to the non-infringement and invalidity issues decided against him because no disputed fact questions existed as to those issues.

There is yet another compelling reason why disposition of the present case by summary judgment does not

* This rationale has been followed in a number of cogent decisions, most notably, *National Life Insurance Company v. Silverman*, 454 F.2d 899 (D.C. Cir. 1971), and *Webster v. Offshore Food Service, Inc.*, 434 F.2d 1191 (5th Cir. 1970).

** Summary judgment was denied as to other grounds (e.g., prior art) asserted by Respondents because the District Court concluded that factual issues existed as to these other grounds.

conflict either directly or in principle with the *Beacon Theatres* and *Dairy Queen* decisions. This Court properly recognized in those cases that the District Court had attempted *sua sponte* to usurp and foreclose the right to trial by jury by imposing upon the party seeking such a trial a preliminary non-jury trial on equitable issues. Unlike *Beacon Theatres* and *Dairy Queen*, the present case is one in which an extensive separate trial on the laches and estoppel issues resulted, not from the District Court's *sua sponte* action, but rather from a *request initiated by Petitioner himself.* Accordingly, the guiding principles or motivating factors underlying *Beacon Theatres* and *Dairy Queen* are wholly absent here.*

Petitioner's Third Question takes a slightly different tack as to whether the Court of Appeals erred in affirming the action of the District Court with respect to Respondents' Motion for Summary Judgment. Petitioner argues that the decisions below conflict with this Court's decision in *Adickes v. Kress & Co.*, 398 U.S. 144 (1970).

The *Adickes* case involved a conspiracy count in a civil rights case, in which the respondent, in moving for summary judgment, had failed to foreclose the possibility, asserted by the petitioner, that there was a policeman in the respondent's store when the petitioner was denied

* In this case, the decision of the District Court on the issue of non-infringement was not raised *sua sponte*, as erroneously asserted by Petitioner (Pet. p. 14). The District Court, in construing the asserted claims of the patent in suit as being limited to glow tube keyers in order to preserve their validity, simply held as a matter of law and in the alternative that there was no infringement, since Petitioner had already admitted that none of the accused devices utilized a glow tube keyer of any type. This was merely an inherently logical extension of Respondents' position regarding invalidity of Petitioner's claims if interpreted to embrace more than just glow tube keyers.

service. The petitioner had contended that the policeman reached an understanding with some employee of the respondent to the effect that the petitioner not be served. Clearly, there was a fact issue to be resolved.

The record below in the instant patent infringement case is an entirely different matter. As correctly determined by the District Court and affirmed by the Court of Appeals:

> There are no issues of fact material to the issue of validity which are in dispute since the prior art, history of the prosecution of the application leading to the issuance of the patent and the patent itself are all documents capable of interpretation upon examination and all other facts relevant to validity are undisputed. (189 U.S.P.Q. at 716; App. 3a)*

Petitioner here argues that the "non-foreclosed possibilities" which precluded summary judgment were (1) that the 1955 Lowrey Model SS had *only* AC keying and no DC keying, and (2) that this Lowrey model was only

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* The District Court was fully aware of its limitations in light of Petitioner's request for a jury trial:

> It is fundamental that the defense of invalidity, as well as those of laches and estoppel, is an affirmative defense, and the burden of proof with respect thereto rests on defendants. In addition, the validity of patent claims, like the issue of laches and estoppel, is a question of law and the fact that plaintiff is seeking a jury trial does not affect the appropriateness of summary judgment if there are no disputed material facts. *Research Corp. v. Nasco Industries, Inc.*, 501 F.2d 358, 182 U.S.P.Q. 449 (7th Cir. 1974); *Armour & Co. v. Wilson & Co.*, 274 F.2d 143, 124 U.S.P.Q. 115 (7th Cir. 1960). It is also fundamental that summary judgment under Rule 56 of the Federal Rules of Civil Procedure may be granted only if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. (189 U.S.P.Q. at 717)

"experimental" and therefore incapable of "public use" (Pet. p. 20). But to so argue is to ignore the record in an effort to fabricate an appealable issue.

Respondents affirmatively proved at the laches and estoppel trial by the unchallenged testimony of Walter J. Anderson, Lowrey's chief engineer and the designer of the Model SS, that the 1955 Lowrey Model SS had both DC and AC keying. Indeed, Petitioner himself recognized this when he charged the Model SS with infringement on account of its DC keying (App. 11a). This unrefuted evidence from Anderson, coupled with Petitioner's own accusation of infringement as to the Model SS, foreclosed the possibility of a fact question concerning the presence of DC keying in the Model SS. Petitioner never challenged this conclusion until appeal when he urged an allegedly contrary inference that could be derived from a report by Young, a Hammond engineer. The Court of Appeals carefully reviewed Petitioner's contention and found that an "*apparent* inconsistency" between Anderson's testimony and the Young documentary evidence belatedly seized upon by Petitioner was not an *actual* inconsistency. Thus, the Court concluded that no disputed fact or "non-foreclosed possibility" actually existed (App. 9a-11a).

Moreover, the Court of Appeals ruled that Petitioner's contention regarding the Young report even if sound was "[i]n any event" waived by Petitioner's failure to raise the issue before the District Court pursuant to Rule 56(e) F.R.Civ.P. (App. 11a). This failure is in marked contrast to the situation in *Adickes* where the petitioner "in opposing summary judgment" expressly relied upon and pointed to matters of record that "creat[ed] an issue of fact as to what [respondent's]

motives might have been in ordering the refusal of service" (398 U.S. at 156-7).*

The Court of Appeals in this case obviously recognized this crucial distinction from the *Adickes* situation for, as noted by Petitioner, *Adickes* was urged twice and rejected (Pet. p. 19). Aside from lack of merit, Petitioner's contention regarding the Young report as a "non-foreclosed possibility" was simply waived because it was not raised in opposition to the motion for summary judgment as required by the *Adickes* interpretation of Rule 56 F.R.Civ.P.

Similarly, the Court of Appeals expressly considered and rejected the Petitioner's fall back argument concerning an alleged second "non-foreclosed possibility", *i.e.*, that the Model SS was "experimental":

> The public exhibit and demonstration of the Lowrey Model SS at the Chicago show, regardless of a Hammond Organ employee's description of it as experimental, satisfies the term "public use" as used in *Muncie Gear* and 35 U.S.C. § 102(b). *Cloud v. Standard Packaging Corp.*, 376 F.2d 384, 389-390 (7th Cir. 1967). (App. 13a).

Petitioner misconstrues the import of the Court of Appeals' decision, arguing that the Court recognized that "non-foreclosed possibilities" existed, but incorrectly held that it was Petitioner's burden to offer affirmative evidence on the issue to stave off summary judgment (Pet. p. 21). But Petitioner is wrong. The Court of Appeals specifically held that there were no "nonforeclosed possibilities" and that in any event Petitioner had waived his opportunity to claim otherwise because of his belated contentions. In short, since Petitioner did not establish before the District Court any dispute concerning a material fact in opposition to the motion, summary judgment was proper.

* Notably, Petitioner has failed to mention that this Court in *Adickes* recognized that the burden shifts to the party opposing a motion for summary judgment when the movant has met the initial burden:

> If respondent had met its initial burden by, for example, submitting affidavits from the policemen denying their presence in the store at the time in question, Rule 56(e) would then have *required petitioner to have done more* than simply rely on the contrary allegation in her complaint. (398 U.S. at 160; emphasis added)

II. AS TO THE SECOND QUESTION

Essentially, Petitioner argues that the Court of Appeals erred, and this Court must intervene, because he believes: (1) there is no statutory basis specified by the Court of Appeals in support of its affirmance of the District Court's finding that Claims 12 and 13 are invalid if read to cover more than the disclosed glow tube electronic keyers; and (2) the Court of Appeals improperly read an element into Claims 12 and 13.* These arguments are specious. Even if supportable, they do not present special or important questions justifying intervention by this Court.

The crux of Petitioner's argument is that the District Court and the Court of Appeals read an element (nowhere identified by Petitioner but obviously intended to be "glow tube keyers") into Claims 12 and 13 (see, *e.g.*, the cases cited at Pet. p. 18). But neither Court read anything into Claims 12 and 13. They simply interpreted

* Claims 1, 12, and 13 of the Faulkner patent are reproduced in the Court of Appeals' decision (App. 9a, 14a). These are the only claims alleged to have been infringed. Petitioner has admitted that Claim 13 is dependent on Claim 12 and that they differ only in that the signal channels of Claim 13 are specified as having different transmission characteristics (App. 14a).

the language of Claims 12 and 13 narrowly in light of the patent specification and accordingly limited the claims to glow tube keyers as disclosed in order to preserve their validity:

> Nowhere in the original application is there any reference to anything other than neon glow tubes as keying devices. Throughout the entire six years' prosecution of the application, only neon glow tubes were disclosed as the electronic keying devices in the patent specifications. (App. 6a)

As held by this Court in *United States v. Adams*, 383 U.S. 39, 49 (1966), it is fundamental that claims must be construed in light of the specification, and both the claims and the specification must be read with a view to ascertaining the invention.* Thus, both the District Court and the Court of Appeals properly read Claims 12 and 13 in the light of the patent specification and held that those claims were limited to glow tube keyers.**

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* Even the cases cited by Petitioner (Pet. p. 18), in an attempt to show that a conflict exists, reaffirm rather than contradict this fundamental tenet of patent law. Thus, in *McCarty v. Lehigh Valley Railroad Co.*, 160 U.S. 110, 118 (1895), this Court held that the invention in suit was "of such limited character as to require a narrow construction." And, in *Maclaren v. B-I-W Group, Inc.*, 535 F.2d 1367, 1372 (2d Cir. 1976), the Second Circuit Court of Appeals held: "This rule does not preclude the court from looking to the specifications and drawings for purposes of understanding and interpreting the claims of the patent." Finally, in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419 (1907), this Court noted that while the courts may not add to or detract from the claim, they "may construe the same in view of the specifications and the state of the art . . ."

** A "keyer" or "electronic keyer" is simply an electronic switch (App. 6a). As noted above, the only electronic keyer illustrated or described in the Faulkner patent is a neon glow tube keyer. Since the "non-linear conducting device" language in Claim 1 was interpreted by the Court of Appeals to be restricted to neon glow tube keyers, that language in Claim 1

(Footnote continued on following page)

Petitioner made essentially the same argument before the Court of Appeals that he raises in his Petition. But that Court held:

> This argument is blatantly specious and "not in our opinion tenable" (189 USPQ at 726) when viewed in the light of the patent specifications. *United States v. Adams*, 383 U.S. 39, 49. (App. 14a-15a)

The Court of Appeals also offered an additional basis for construing Claims 12 and 13 to cover only glow tube keyers. A construction of "electronic keyer" as used in these claims as being broader than the keyer set forth in Claim 1 would create the anomalous situation in which two separate and distinct inventions are claimed in the same patent. As noted by the Court of Appeals in the portion of the footnote excised by Petitioner in quoting (out of context) that Court's decision at p. 18 of its Petition:

> However, 35 U.S.C. § 121 also provides that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." By way of 37 C.F.R. § 1.141 (35 U.S.C.A. App. 1 at 690), the Commissioner has made this requirement mandatory. Thus if a claim is ambiguous, *i.e.*, capable of being read as an independent and distinct invention or just another claim of one invention, the statute and regulation together create a presumption against reading the claim as an independent and distinct invention. (App. 15a)

Obviously, this ruling is in no way inconsistent with the general proposition relied on by Petitioner (see cases

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** *continued*
cannot be relied on for extending and expanding the meaning of Claims 12 and 13. Recognizing this, the Court of Appeals noted "the term 'electronic keyer' in Claims 12 and 13 does not have a different meaning than the described keyer in Claim 1". (App. 15a)

cited at Pet. p. 15) to the effect that the invalidity of one claim of a patent need not necessarily affect the validity of another.

The Petitioner's Second Question is contrived and not supported by the record. The Court of Appeals did not read any element into Claims 12 and 13; it merely construed them in accordance with the patent specification. Thus, there is no conflict with any decision of this Court. And, the Court of Appeals explicitly cited statutory underpinnings for its finding that Claims 12 and 13 would be invalid if construed broadly. The mere fact that these underpinnings were cited in a footnote* does not render the Court of Appeals' decision "in direct conflict with 35 U.S.C. § 282" as Petitioner suggests.

III. AS TO THE FOURTH QUESTION

The Fourth Question simply inquires as to whether the Courts below correctly construed *Muncie Gear*.

The "late claiming" bar of *Muncie Gear* is summarized correctly by the District Court (189 U.S.P.Q. at 721) and by the Court of Appeals:

> The [Supreme] Court concluded that, since a new application would have been statutorily barred if made more than two [now one] years after the first public use or sale of a device embodying the alleged invention, an amendment seeking to achieve indirectly what could not have been achieved directly, was improper and the patent invalid.** (App. 5a)

* Of course, this statutory basis is also referenced in the main text of the Court of Appeals' decision, in the context of the basis for the District Court's decision expressly affirmed by the Court of Appeals (App. 4a, 14a).

** Petitioner conceded that Claim 1 could *not* be read on the Lowrey Model SS Organ prior to its enlargement by amendment in December, 1956.

The effect of applying *Muncie Gear* to the patent in suit is to limit it to glow tube keyers as a matter of law.* This is appropriate because, as the Court of Appeals held:

> Nowhere in the original application is there any reference to anything other than neon glow tubes as keying devices. Throughout the entire six years' prosecution of the application, only neon glow tubes were disclosed as the electronic keying devices in the patent specifications. (App. 6a)

Petitioner argues that the Court of Appeals misapplied the *Muncie Gear* doctrine to the instant case because the actual application for the patent in suit disclosed more than glow tube keyers. But, both the District Court and Court of Appeals expressly held that the patent in suit discloses only glow tube keyers. Thus, the basis for Petitioner's argument is lacking, and his Fourth Question is specious.**

Petitioner's further reliance on numerous cases cited in his Petition, in an effort to contrive a "conflict" among the circuits and thereby sustain his frivolous Petition, is unavailing. *Engineering Development Lab v. Radio Corp. of America*, 153 F.2d 523 (2d Cir. 1946) (Pet. pp. 23-4), involved a case where the amendments to the claims in dispute were supported by the language of earlier claims pre-dating the alleged prior public use, 153 F.2d at 525-526. *Binks Mfg. Co. v. Ransburg Electro-Coating Corp.*, 281 F.2d 252 (7th Cir. 1960) (Pet. p. 23), involved the claim language "bridging", which the Court

* Significantly, the District Court determined that Petitioner's conduct during the period 1957-72 (before filing suit) corroborated this conclusion. (189 U.S.P.Q. at 724)

** Similarly, the Petitioner's citation of *King-Seeley Thermos Co. v. Refrigerated Dispensers, Inc.*, 354 F.2d 533, 539 (10th Cir. 1965) (Pet. p. 23), is inapposite.

held was inherent in the original disclosure of the patent application. Thus, both cases involved circumstances wholly different from the instant case, where the Court of Appeals held there was no generic or inherent disclosure in the Petitioner's application of a "non-linear conducting device" as claimed in Claim 1.

Petitioner, recognizing that no real conflict exists with any decision of this Court or within the circuits, attempts to generate such a conflict by misconstruing this Court's decision in *Muncie Gear*:

> From the foregoing, it can be seen that the *Muncie Gear* doctrine does not come into operation merely by the amendment of claims, or by the insertion of new claims by amendment, during the course of prosecution of an original patent application. The *Muncie Gear* doctrine comes into play in connection with an original patent application only when the description of the invention is amended subsequent to the critical date established by 35 U.S.C. § 102(b), and when such description then provides a basis of support for claims that are then, or later, also amended or introduced by amendment. (Pet. p. 25)

Thus, Petitioner argues that *Muncie Gear* is a "late specification amending" case, not a "late claiming" case. Such a position is untenable, in view of the numerous cases consistently holding that *Muncie Gear* espouses a "late claiming" doctrine. There is no conflict, for as expressly stated by this Court in *Muncie Gear*:

> The *claims* in question are invalid if there was public use, or sale, of the device which they are *claimed to cover*, more than two years before the *first disclosure thereof to the Patent Office*. (315 U.S. at 768; emphasis added)*

* Indeed, two of the claims struck down in *Muncie Gear* had nothing whatsoever to do with the amendment to the specification. See 315 U.S. at 763.

In any event, such considerations are academic in view of Petitioner's own recognition that claims broadened by amendment after public disclosure escape the proscription of the *Muncie Gear* doctrine only if they "are supported by the original disclosure" (Pet. p. 24). The District Court and the Court of Appeals in this case specifically held that Claim 1 was valid if limited to glow tube keyers—as supported by the original disclosure—but invalid under *Muncie Gear* if expanded to cover more than glow tube keyers—because not supported by the original disclosure.

Thus, no real issue is presented by the Fourth Question of the Petition, since the extant decisions in this case are fully consistent even with Petitioner's arguments.

CONCLUSION

Nowhere in his Petition has Petitioner demonstrated any substantial reason or basis for granting a Writ of Certiorari. Not only has he failed to show that any error occurred in the proceedings below, he has not demonstrated that his case involves any of the considerations governing review on certiorari as outlined in Supreme Court Rule 19. The Petition presents no special or important reason why the Writ should be granted. There is no conflict between the decisions of any Courts of Appeals. There is no Federal question which has been decided in conflict with any decision of this Court. And there has been no departure from the accepted and usual course of judicial proceedings.

Respondents respectfully submit that the Petition is without merit and should be denied.

Respectfully submitted,

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